

# Inventions, Patents and Designs

With Notes and the Full Text  
of the

New British Patents & Designs Acts,  
1907 and 1908

BY

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## INTRODUCTION.

### FOSTERING OR LOSING INDUSTRIES.

THERE are many methods of fostering industries, but those dependent upon artificial restraints or non-commercial conditions are unquestionably the least satisfactory for the national as against the purely individual advantage. Were this otherwise, the immense success that has attended the unfettered production of the engineering, mechanical, and general manufacturing and constructive industries of Great Britain in face of the open competition of the world could not be recorded.

Many of the industries that are now in successful operation in different countries had their birth and origin in Great Britain. Owing to other and newer countries coming into the world's market, thereby creating wider demands than was originally considered possible, the originating country is unable to supply the whole of the demands. Where, however, improvements and adaptations to varying needs have been effected, original manufacturers and producers can still satisfactorily produce and keep abreast, even if not actually lead, in competition with those newer factories and works that have been subsidised and developed by foreigners from our original constructions and directions.

While there is in many cases a certain degree of prestige attached to the originating firm or originating

nation, yet if the developments and increasing needs of others are not recognised and provided for by adaptations that go towards securing a betterment of the productions, it may be assuredly stated that such prestige will soon be forgotten, and the trade passed to those who are less fettered by habit and less hampered by old ideas than those who were probably the best people in the early days when the industries were initiated by them.

It cannot be too readily borne in mind that invention is of international rather than of national growth, and that as with science, so with manufacturing arts and industries, no country can claim a monopoly in that type of mind and intellect that originates, develops, and discovers improvements.

Developments and modifications are always possible, and improvements become imperative either in the processes, forms, or methods in relation to every conceivable constructive or manufacturing industry. Were that not so, it would presuppose a cessation of thought and a blindness to the possibilities of adapting developments or improvements in one art, to become aids in improving or developing other arts. There is no such state as absolute finality or perfection, either in industrial productions or in the universal realm of invention. It is to this fact that the firm or individual who originates a new manufacture or a new method of combining old elements for securing better results must not be content to rest satisfied with what has been produced, even though it is of considerable profitable importance for the time, but must be on the alert to simplify, alter, modify, or vary that which is being produced, or competitors will be engendered, as others will be encouraged or forced to produce what is demanded by more economical and possibly by more efficient methods. While the origina-

ting firm produces in the most economical manner and is accommodating in its methods when dealing with varying demands, there is no inducement for rivals to enter into a new field, or if they do so enter they are under a disability when competing with the older and experienced firms. Many of the failures or losses in supremacy that have arisen in some of our British industries can be definitely traced to neglect on the part of the older firms to keep intelligent minds on that upon which they were engaged. They have taken liberties with the trade, and, as a consequence, this has been transferred to more obliging, more efficient and considerate firms. Improvements have been ignored or discouraged by old firms owing to a self-satisfied air which seemed to possess the whole of the principals, and there are instances known to all who are familiar with the prejudices and stereotyped habits of some of our manufacturers amply sufficient to account for the departure of the trade that was once exclusively confined to certain districts in this country. It is probable that at the outset of their careers the founders of firms that have now departed were by necessity keenly alive and industrious, but as success attended their enterprises they apparently lost the faculty for appreciating betterment, and could or would not recognise opportunities for further improvement that were offered or demanded by others.

Some British manufacturers have a peculiar habit of keeping the nature of their business a secret in the districts where they reside and within the social circle they cultivate. With the object of masking their actual pursuits they affect an interest in stocks and shares or in rural and country pursuits, sports, and pastimes. Where this spirit prevails, and where neither pride or pleasure is developed in the business or industry, it is not surprising



that suggestions for improvement are not appreciated, and that opportunities for betterment as to the output are ignored or not recognised.

The sons and successors of those who founded business undertakings frequently ignore such industries, and evince neither desire or aptitude for keeping to the front or leading with new features in the commercial race. Habits of indolence lead to the rejection of proposals that are made such as would involve any alteration of plant, the scrapping of old machines, and the adoption of more modern methods for meeting in an economical manner the newer demands of fresh markets, and consequently other foreign competitors are encouraged to embark against them.

That it should be possible to thus condemn many British manufacturers for driving trade away from this country is an appalling commentary upon one of our weak national traits of self-confidence and insular narrowness. It is from the principals rather than the staff or the workers that attention must be directed if we are to hold our own, and there must be as keen an interest evinced in this country as in America by those who, when engaged in manufacturing and commercial enterprises, are personally proud and publicly and privately interested in what they are producing, be it pigs, paper, or phonographs, ships, steel, or string.

G. CROYDON MARKS.

## CHAPTER I.

### THE MEANING OF "PATENT."

THE term "patent" has become a recognised expression when applied to inventions and industries for indicating exclusive ownership or proprietary rights in some particular manufacture, some new process of manufacturing an old product, a new machine, a new combination of old elements, or some novel article or device that has been discovered, devised, originated, combined, or invented, or first introduced into the country by the person or persons to whom the Crown has, by Royal "Letters Patent" or open letters, conferred a conditional and personal monopoly or sole and exclusive license to use, make, vend, and exercise the said invention for a limited period. The period of protection is for fourteen years, commencing from the day when the application was made for securing such royal grant or protection in the form of letters patent from the Monarch or Head of the State.

The object of the grant is to encourage new manufactures and new industries within the realm; but while these new manufactures are to be encouraged, every grant expressly provides that certain conditions must be observed by the person obtaining it in order that the existence of such grant when obtained shall not be capable of being set aside or impugned by others.

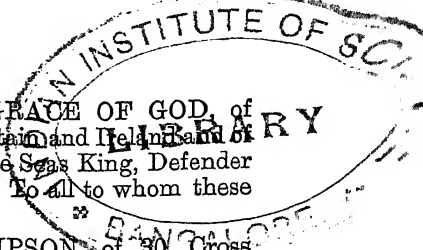
There is considerable misconception concerning the intention of the Crown in granting that which is for the time being practically a monopoly to the inventor or first introducer who becomes the patentee. It is not so much a matter of reward for ingenuity that the patent is granted or protection given to the inventor, as an

inducement to the inventor to give away for the benefit of the public and the realm that which otherwise the public would never have possessed but for his industry and invention in discovering. The Crown in effect says to the patentee, "If you will divulge that which you have discovered, and which you intend to keep for your secret benefit, so that the whole realm may share in the advantages of your invention, we will grant to you our letters patent, forbidding and restraining any other person in the realm from making or copying that which you publicly make or sell during a period of fourteen years." By this arrangement the patentee becomes possessed of a power direct from the Crown to protect himself against pirates, copyists, and infringers, whom he would not be able to otherwise restrain, did he produce the articles in a secret manner or manufacture them by methods which possibly others might discover hereafter. In effect, he gives up his exclusive right to manufacture secretly, at the risk of some one else finding out his methods, for an assured royally protected period of fourteen years during which time no other person can use, or improve upon his invention, in order that he may be relieved from any uncertainty as to his position when others might discover his secret and then use it, and that he may be safe against the illegal acts of others in copying or infringing that which he has originated.

The whole spirit of the grant, however, is in definitely rigid terms conditional upon the inventor depositing at the Patent Office a complete specification by means of which others may be properly instructed in the invention and wherein he particularly describes the nature of such invention, at the time in which he applies for the patent, and, further, that he makes the declaration that he is the true and first inventor thereof, and that the same is not in use by any other person to the best of his knowledge and belief.

## THE GRANT.

The grant of every patent contains a proviso or preamble made by the Crown in the following terms :—



"EDWARD VII., BY THE GRACE OF GOD, of the United Kingdom of Great Britain and Ireland, and of the British Dominions beyond the Seas King, Defender of the Faith, Emperor of India: To all to whom these presents shall come greeting:

"WHEREAS HENRY THOMPSON, of 30, Cross Street, Manchester, Engineer, hath declared that he is in possession of an invention for 'An improved gas engine,' that he is the true and first inventor thereof, that the same is not in use by any other person to the best of his knowledge and belief;

"AND WHEREAS the said inventor hath humbly prayed that a patent might be granted unto him for the sole use and advantage of his said invention;

"AND WHEREAS the said inventor hath by and in his complete specification, particularly described the nature of his invention;

"AND WHEREAS we being willing to encourage all inventions which may be for the public good, are graciously pleased to condescend to his request."

From this it will be seen that the essence of the grant is in effect a virtual contract between the inventor and the Crown, but only contracted by the Crown because of a willingness to encourage all inventions which may be for the public good. There is not a benevolent desire solely to give a prize or reward for ingenuity, for a governing proviso in the grant forming the continuing part of the Letters Patent recites as follows:—

"KNOW YE, THEREFORE, that We, of our especial grace, certain knowledge, and mere motion do by these presents, for us, our heirs and successors, give and grant unto the said patentee our especial license, full power, sole privilege, and authority, that the said patentee by himself, his agents, or licensees, and no others, may at all times hereafter during the term of years herein mentioned, make, use, exercise, and vend the said invention within our United Kingdom of Great Britain and Ireland, and Isle of

"Man, in such a manner as to him or them may seem  
"meet, and that the said patentee shall have and enjoy  
"the whole profit and advantage from time to time  
"accruing by reason of the said invention, during the  
"term of fourteen years from the date hereunder written  
"of these presents; AND to the end that the said  
"patentee may have and enjoy the sole use and exercise  
"and the full benefit of the said invention, We do by  
"these presents for us, our heirs and successors, strictly  
"command all our subjects whatsoever within our  
"United Kingdom of Great Britain and Ireland, and the  
"Isle of Man, that they do not at any time during the  
"continuance of the said term of fourteen years either  
"directly or indirectly make use of or put into practice  
"the said invention, or any part of the same, nor in  
"anywise imitate the same, nor make or cause to be  
"made any addition thereto or subtraction therefrom,  
"whereby to pretend themselves the inventors thereof,  
"without the consent, license, or agreement of the said  
"patentee in writing under his hand and seal, on pain of  
"incurring such penalties as may be justly inflicted on  
"such offenders for their contempt of this our Royal  
"Command, and of being answerable to the patentee  
"according to law for his damages thereby occasioned;

"Provided that these our Letters Patent are on this  
"condition, that if at any time during the said term  
"it be made to appear to us that this our grant is con-  
"trary to law or prejudicial or inconvenient to our  
"subjects in general, or that the said invention is not a  
"new invention as to the public use and exercise thereof  
"within our United Kingdom, or that the said patentee  
"is not the first and true inventor thereof within this  
"realm, these our Letters Patent shall forthwith deter-  
"mine and be void to all intents and purposes, notwith-  
"standing anything hereinbefore contained: PROVIDED  
"ALSO, that if the said patentee shall not pay all fees by  
"law required to be paid in respect of the grant of these  
"Letters Patent, or in respect of any matter relating  
"thereto at the time or times, and in manner for the  
"time being by law provided; and also if the said  
"patentee shall not supply, or cause to be supplied, for

“our service all such articles of the said invention as  
 “may be required by the officers or commissioners  
 “administering any department of our service in such  
 “manner, at such times, and at and upon reasonable  
 “prices and terms as shall be settled in manner for the  
 “time being by law provided, then, and in any of the  
 “said cases, these our Letters Patent, and all privileges  
 “and advantages whatever hereby granted shall deter-  
 “mine and become void notwithstanding anything  
 “hereinbefore contained: PROVIDED ALSO, that  
 “nothing herein contained shall prevent the granting  
 “of licenses in such manner and for such considerations  
 “as they may by law be granted: AND lastly, we do  
 “by these presents for us, our heirs, and successors,  
 “grant unto the said patentee that these our Letters  
 “Patent shall be construed in the most beneficial sense  
 “for the advantage of the said patentee.”

It will thus be seen that although the grant is made and the inventor may be truly entitled to it, if it is inconvenient, or presses injuriously upon the public, then, notwithstanding such invention would presumably never have been known to the public but for the inventor, the grant is to cease and the Letters Patent become void, so that others may freely benefit by the invention without considering the original inventor or patentee.

### MONOPOLIES ARE ILLEGAL.

There is no similarity between the grant of patents for inventions and the old monopolies that existed prior to 1623, such as after many years of agitation resulted in the forbidding “Statute of Monopolies” being passed in the reign of James I. The Crown in those privileged days was in the habit of granting to favourites or others exclusive rights to manufacture certain commodities that were well known, and to confer preferential consideration for selling or trading in connection with certain goods in certain districts. These had become so oppressive by the actions of the monopolists that all monopolies or restraints of trade

were set out in the Act as being grievous and inconvenient to the subjects of the realm, and were to be absolutely void, with, however, the special exception concerning new discoveries, thereby removing, even in those days, the question of invention from the ordinary category concerning free and unrestricted trade.

There can be no "monopoly" in that which is not already in existence as a common subject of manufacture or common right; therefore if an inventor produced that which had never existed before, and which would have been unknown but for his efforts, the "Statute of Monopolies" recognised that although exclusive privileges or sole interest in selling or dealing in or making ordinary products were to be void and illegal, yet the Crown was to be vested with the power to encourage the introduction of new manufactures by giving conditional privileges or partial monopolies to those seeking for such.

#### OLD DEFINITION OF INVENTION.

The terms setting forth this special exception in the "Statute of Monopolies" recite that patents could be granted for the "sole working or making of any new manufacture within the realm to the true and first inventor of such manufacture, which others at the time of making such Letters Patents and grants should not use, so they be not contrary to law nor mischievous to the state by raising of the prices of commodities at home or hurt of trade or generally inconvenient." This definition of the exception to the grant of monopolies in the time of James I., is in effect the charter covering the grant of all subsequent patents to inventors, and upon this charter the whole patent law absolutely depends. It will be observed that increase or raising of prices is expressly barred, even though the invention be for that which is new.

While, therefore, no "monopoly" can be made if there is not already a common user of the article or process, there can be no such thing as Free Trade in that which is the sole property of another person. Consequently the rights and usages of the public in

connection with ordinary trading have no bearing and form no part of the policy associated with the granting of Royal Letters Patent to inventors or originators of new discoveries or manufactures within any country. It is for this reason that the Crown recognises no difference when granting a patent between the man who first introduces a new invention from abroad into this country, providing he states that he obtained it from some person abroad, and the person or actual inventor who originates or discovers it at home; for the country is equally benefited by the new instruction set forth in the specification of the patent application. Under the British, as well as under the Patent Laws of other countries, an importer or first introducer can obtain a patent as readily as the actual inventor, and is considered as equally entitled to recognition and protection for introducing some new art or manufacture into the country.

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## CHAPTER II.

### WHAT IS PATENTABLE?

MANY confused opinions exist as to the extent and nature of the protection which is obtained by grant of a patent, and valuable industrial enterprises have been ruined by the competition which has resulted from other firms adopting their completed processes without having had to pay for the costly experimental stages which have led up to the final manufacture, owing to such processes not having been patented in the first instance.

Other persons introducing small novelties, having perhaps but trifling new points about them, have risked a secret manufacture rather than proclaim their system, from the mistaken notion that the idea was not worth patenting, or that it was not a subject for patent; whereas the fact is perhaps not sufficiently well known that small inventions are frequently more remunerative to the inventor than many intricate and elaborate ones.



The cost of patenting an invention is now so low, and the profit so great, that no manufacturer or inventor can afford to throw away a conditional monopoly which he can so cheaply obtain, and which, if it is worth anything at all, will soon more than amply pay him for his expense in patenting the invention.

Any new and useful manufacture, art, appliance, machine, apparatus, combination of known appliances, or parts producing new or novel results; any new process or system of manufacturing an old article or an old substance; any improvement or new development of existing articles, appliances, or processes of any kind, can be patented, and will be protected by the law on payment of prescribed fees and depositing a specification setting forth the extent and nature of the invention with the manner of carrying the same properly into effect.

It must be well understood that it is not the principle, but the method of carrying the principle into effect, which is to be patented. It is the process, rather than the product; the mode or system of manufacture, not the manufacturing; it is in effect the new "means," not the "end," that should be patented.

The means, process, system, mode of manufacture, combination, or carrying into effect of any of them, must be new or novel; that is, the invention must not be known or practised by the public at the time of the application for a patent.

The patent, however, will be quite useless and invalid when obtained, even though obtained by the inventor in entire and complete good faith, should the invention or any part of it which is claimed as being new have been publicly used, described, or publicly known in any part of the United Kingdom prior to the application for the patent.

#### SECRET USE—RISKS.

Any person, on becoming possessed of the knowledge as to a new and useful improvement constituting a new discovery, or invention, which he may consider of great

value to himself if he can keep such knowledge from others, has two courses open to him as to carrying his invention into effect. He may either continue to keep his secret to himself, and make use of the same in a private and hidden manner, or he may apply for a patent to enable him to work it publicly, without risk of others adopting it and taking it from him. If he elects to keep his manufacture quite secret and private to himself, without divulging his methods, he may possibly reap a large reward by the extra profit arising to him upon an exclusive manufacture not understood or capable of being adopted by others; but at the same time, should any other person happen to divulge the secret then his special profits come to an end, as there would be open competition. Similarly, if any inventor works his idea out in a private manner, and continues to use his invention for his own private benefit, he cannot in any way prevent any person or number of persons from adopting his secret manufacture or invention, should they by any means happen to become acquainted with it. The only way to prevent others from robbing him of his invention is to apply for letters patent from the Crown for establishing a limited period of monopoly, with absolute protection against all infringers during the continuance of the life of the patent.

An inventor, on applying for a patent, virtually waives his exclusive property in his own secret discovery or invention, without State protection against infringers, in order that he may acquire for a limited period of fourteen years the exclusive enjoyment of the same invention, with full State protection against all who infringe his rights.

#### THE FIRST INVENTOR.

If several persons simultaneously discover or develop the same thing, the one who first communicates his discovery to the public in his application for a patent become legally the true and first inventor, and is entitled to the sole benefit of it. If a servant, while in his master's employment, invents a machine, new article,

or new process, such invention belongs to the servant, and not to the master.

On the other hand, if a master or an inventor employs a mechanic to work out the details of his idea and to carry the invention into practical execution, or to draw out the plans embodying such general idea, then anything suggested or invented by any workman, draughtsman, or person so employed, which is subsidiary to the main idea, is the invention of the employer or the patentee. The test for the extent of this assistance becomes a complicated one in some cases, but when the principle and the object of the invention are complete without it, then the validity of the patent is not affected by the name of the assistant not being included in the patent as a joint inventor with the employer. If, however, any person is engaged as a manager or to fill any position where his special skill is expected to be used in his work, then any invention devised or invented by him will become the property of the employer. It has been held that the employee in such circumstances has no interest in the industry apart from his employers.

#### THE PATENTEE.

Any person, whether a British subject or a foreigner, may obtain the grant of letters patent for his or her invention; and a patent will be granted jointly to two or more persons, even though but one of them is the originator of the discovery, or is the actual true inventor.

This system enables a capitalist or a company to join an inventor for the purpose of assisting him, and to share with him the benefits of the protection which the patent provides. It also permits a master to join with a servant in developing a new and valuable discovery, with perfect security as to his equal interest in the invention, thus affording him a guarantee that the money therein invested will be, in very large degree, under his own control in the matter of developing or disposing of the patent.

#### JOINT PATENTEES.

Considerable difficulty has hitherto been experienced

in the case of patents that have been granted to two or more persons conjointly, as misapprehensions arose very frequently concerning the person who was entitled to use the invention or to grant a license therefor. Under section 37 of the new law, inventors are protected by the fact that each one is able to work the invention without having to account to the other or without having to declare his profit, but no license, however, can be granted other than by the consent of all the applicants. It is desirable that an agreement should be entered into at the outset of the engagements, whereby the rights and interests of the parties in the invention should be left in the hands of one individual, otherwise considerable difficulty may arise on a transfer of the patent being proposed on terms not satisfactory to either of the parties.

#### IMPORTATION.

Any invention which is well known abroad, but which is not known here publicly, and which has not been described in any book circulated in this country, can be patented by the person first publicly importing it, and he becomes, in the eye of the law, the true and first inventor of it. He is, in effect, doing precisely what any other original inventor does when applying for a patent, viz., instructing the public in a new or useful art or manufacture not previously known or practised in this country. If the foreign original inventor has sold all interest in his invention abroad, he can, nevertheless, apply for a British patent, which is not affected by the foreign transaction, unless, of course, special restricting conditions have been imposed.

#### INTERNATIONAL CONVENTION.

An International Convention or Union for the protection of industrial property exists between certain countries, of which Great Britain is one, whereby the citizens of each contracting country are afforded mutual protection by a period of grace being allowed in their own country during which they may publicly use, test, or

experiment with their inventions. Any invention for which any application is subsequently made in the foreign countries for patents within the stipulated period of twelve months will be protected as from the date of the original application for a patent in England.

#### HOW A PATENT IS OBTAINED.

The inventor who is desirous of obtaining a patent has to apply for the same on proper forms issued from the Patent Office and the chief money order offices in the United Kingdom. This application comprises a statement that the applicant is in possession of an invention the title of which is therein set forth; that he is the true and first inventor thereof; and that the same is not in use by any other person or persons to the best of his knowledge and belief.

When two or more persons jointly apply for a patent, the application must state which one, or who among the applicants, has invented such improvements. This application form must be signed by each and all the applicants, or sealed if by a limited company, but all subsequent proceedings may be conducted through an agent, who signs all further documents and drawings.

In making the application for a patent, two courses are open to the inventor. He may either apply for provisional protection for his invention, or he may apply for a complete patent without any period being allowed him for developing and finishing his invention.

In making his application for provisional protection, he obtains a period of six months, or, if desired, a month's extension will be granted on paying £2, making seven months' experimental or developmental period, during which time he may thoroughly work out and bring to best advantage the idea conceived when he first determined to apply for a patent.

#### PROVISIONAL PROTECTION.

The applicant for a patent who decides to secure his idea or invention at the earliest possible date, to avoid risk in perfecting his methods, does wisely in applying

for provisional protection as soon as he is sure of his proposals being possible. The form on which the application is made is impressed with a stamp of £1, and no further fee is payable to the Government Patent Office for such protection.

It is at the early stage of the existence of an invention that technical skill is a necessity to the inventor, seeing that the subsequent complete specification, which is to be particularly and accurately descriptive of the invention, has to be based entirely upon what has been set forth in its provisional specification. There are very few inventions of importance in connection with the manufacturing arts and industries which go upon the market, or which are commercially employed and carried out, in precisely the same manner that the discoverer or inventor originally contemplated. The development of the process in the manufacture of the machine, appliance, or article becomes more perfect by the experience which time and trial alone could suggest; and thus it is of the highest importance to the inventor that he should avail himself of the full benefits of the protection afforded by the patent laws by depositing with his application for a patent not a perfectly and particularly detailed specification or description of his invention, but rather a broadly outlined and comprehensively worded description, to embody or anticipate the proposals which exist or may arise as to the method of producing the article or carrying out the process which is the subject of his invention.

#### THE PROVISIONAL SPECIFICATION.

A provisional specification is of very great value to all classes of inventors, for in the matter of small articles, which may be introduced most probably by inventors desirous of studying economy, the period of six months enables them to test the market or commercial value of the invention at a trifling cost, and it enables the inventor to negotiate with a manufacturer, a capitalist, or others likely to be interested, without risk of his idea being taken from him, and with a full assurance as to his security in publicly offering his discovery to others.

To the manufacturer or wealthy firm, or the inventor of some complicated machine, new engine, or new process, the full extent of which has not been actually demonstrated by experiment, the provisional period provides a time during which he may avail himself of the services of others to work out his details and carry into practical effect his suggestions, without fear of piracy being possible from those thus engaged by him.

If foreign patents are to be applied for, the inventor has time in which to decide upon the countries in which to apply, and he has the further advantage, if he so wishes, of applying for an American or German patent early in the period under his provisional protection, and then taking full advantage of the claims which the United States and German system of exhaustive examination of other foreign patents have suggested as being in the opinion of the foreign examiners valid and novel.

#### PATENT OFFICE EXAMINATION OF SPECIFICATION.

Every application for a patent, with its provisional specification, is referred to an examiner, who reports to the Comptroller-General if the nature of the invention has been fairly described and set forth in the specification, if the descriptive title is correct, if the documents have been properly filled up, and whether the specification describes more than one invention.

These four points alone at this stage receive attention by the examiner, who is not entitled or allowed to decide any question as to whether any existing patent has been granted for the same or similar object, neither is he required to decide as to the utility of the invention in any way.

#### INFRINGEMENT BEFORE SEALING.

It must be borne in mind, however, that no action for infringement can be instituted before the sealing of a patent, and no damages can be obtained for any infringement that may occur before the acceptance of the complete specification. This period of free manufacture is, however, of little detriment to an inventor, seeing

that the infringer runs the risk of having to pay damages owing to the inventor electing to file his complete specification very soon after his provisional, and this practically compels the manufacturer, who may have made a stock of articles in the expectation of a six months' period of sale, free from royalties, either to destroy his stock existing when the complete specification has been accepted, or to pay royalties upon each and every article then to be sold.

#### SUPPLEMENTARY PROVISIONALS.

One of the new features of the Patent Act passed in 1907, has reference to the possibility that is granted the inventor of introducing into one patent a number of improvements that, under the old Act, would have required several patents to validly protect. Section 16 provides for supplementary provisional specifications being filed during the period of six months from the date of the first application, and then for one complete specification to be lodged at the end of the six months to cover the whole of such applications and a single patent to be granted thereon. This feature will be of great value in connection with inventions relating to mechanical combinations, as it is in the earlier period of construction that improvements in detail become necessary, which, in themselves, are probably not absolutely described or foreshadowed in the original specification. The only proviso governing the deposit of such supplemental applications is that having reference to unity of the invention, so that the patent, when granted, although describing various means and different methods, will, in fact, be in accordance with the requirement of the Act still covering only a single invention.

#### THE COMPLETE SPECIFICATION.

After an applicant has obtained provisional protection and has fully carried out the ideas embodied or described in his provisional specification, he is required to deposit at the expiration of six months, or seven months under an extension allowance, a more definite, detailed, and



clear specification, which must be accompanied by drawings if necessary, setting forth particularly the nature of the invention, the manner of carrying it into effect, and the claim he desires to secure. This complete specification, which bears a £3 stamp upon it, is of the highest importance, as it controls the validity of the patent granted, for should any matter be included in the specification, and then be claimed by it, which is old or not novel, then the patent is absolutely invalid, even though there are other elements of utility and novelty not affected by the anticipatory matter contained in the same specification.

The specification need not be filed if the applicant decides that his invention is not of material novelty from information obtained by him during his provisional period, or if he concludes that the invention will not repay him for the step. In the event of no complete specification being filed by the applicant, his provisional specification, filed with his application, is never published, and therefore does not debar him from subsequently developing his idea and then fully patenting it, providing that no commercial or public use has been made by him of the invention described in his original application.

#### PATENTS WITHOUT PROVISIONAL PROTECTION.

In the event of an applicant deciding to secure a complete patent in the first instance, without obtaining provisional protection, he must deposit with his application the ordinary A form, bearing an impressed stamp of £1, and also the complete C form, bearing a £3 stamp, making the same stamp fee payable, viz., £4, which is paid for every complete patent granted, whether with or without provisional protection being applied for. Thus it is no economy, from the point of view of the stamp fees payable, to dispense with the provisional application; while the advantages of a definite development period of six months cannot be over-estimated for most inventions.

#### FRAUDULENT PRIOR PUBLICATION.

Very considerable injury has been caused inventors in

the past owing to fraudulent prior publication of particulars concerning the invention being made by persons who had in an unauthorised manner obtained particulars or some knowledge of experiments, and by such publication had deprived the experimenters from the possibility of obtaining valid patents for their inventions. This evil is remedied in the new Act in section 41, sub-section 2, which provides that :—

“A patent shall not be held to be invalid by reason only of the invention in respect of which the patent was granted or any part thereof having been published prior to the date of the patent, if the patentee proves to the satisfaction of the Court that the publication was made without his knowledge and consent, and that the matter published was derived or obtained from him.”

While this provision is extremely useful in protecting inventors against any unauthorised publication, it may be attended with some disadvantage, in that the way may be opened for persons to obtain patents after they have publicly used the invention in such a manner as to lead others to believe that there was no intention of applying for a patent therefor.

### THE PATENT OFFICE SEARCH.

Every complete specification deposited at the Patent Office is referred to an examiner, whose duty is to ascertain : 1st, Whether the complete specification and drawings have been prepared in the prescribed manner; 2nd, Whether the invention described in the complete specification is substantially the same as that described in the provisional specification or specifications; 3rd, Whether the invention has been wholly or in part claimed or described in the complete specification of any British patent published within fifty years before the date of the application.

It is no part of the duty of the examiner to ascertain whether the invention is useful or whether it is in fact an infringement of another patent, or whether it purports to describe as new that which is well known in literature or in other specifications of foreign countries that may be

existing in the Patent Office. The search of the examiner is confined to the specifications of patents that have been granted in the United Kingdom, and is not for the purpose of determining whether the invention possesses good subject-matter or whether it is novel so far as the public knowledge of the art and industry is concerned, but is only to determine whether in fact a patent has been previously granted in the preceding fifty years for the same invention or any part of the same invention described and claimed in the applicant's specification. It is intended to take away from the British Patent Office a reproach that was once with truth made, that it granted patents for the same inventions to as many different applicants as might seek to pay the fees to obtain the patents. While, therefore, this particular reproach against the British Patent Office is removed, in that an official search is now made of that which has been patented during the preceding fifty years in this country, the error must not be fallen into of supposing that the patent when granted will be capable of being sustained as novel or in any respect valid in any Court, seeing that various objections can be successfully brought against the validity of a patent when in Court on an infringement action that never come before the examiners at the Patent Office, and are not capable of being considered by them.

#### INTERPRETATION OF THE SPECIFICATION.

The language of the specification must be clear, and capable of being followed by those for whom the invention is designed—that is to say, the skilled workmen engaged in the particular trade or calling who will have to construct the article, or carry out the process described in the specification, must be able to work to the instructions and drawings given by the patentee. There must be no unusual demand made upon those studying the specification with the desire of learning the nature of the invention, and the manner of performing what is therein described. The specification must fully instruct those engaged in the particular art and industry, and must

leave nothing which is material to the successful result of the invention for the reader to fathom out or invent for himself. There are many inventions wrecked most hopelessly from the insufficiency of the specifications which have been deposited by the patentees.

### THE CLAIMS.

The complete specification is required to end with a statement as to what the inventor claims as being his invention, so as to distinguish from the full statement contained in the descriptive portion of the specification how much the applicant considers is new and how much is old.

In most specifications, in order to properly describe the new matter, it is necessary to introduce descriptions of old constructions and processes with which, probably, the new parts or the new processes are to be combined, so that the greatest care and skill is necessary in differentiating the new from the old. The claims should be drafted with a view of protecting not only what has been specifically set forth and illustrated, but the "pith and marrow" of the invention. On the other hand, the anxiety to prevent imaginary cases of infringement has often led patentees, in drawing their claims, to actually cause a failure in courts of law by the claim covering a principle, and not the method of employing such principle; too wide or too general a claim is open to easy attack by an infringer.

### REFERENCES TO PRIOR PATENTS.

After the search has been made, and when on investigation it appears that the invention has been wholly or in part claimed or described in any prior specification, the applicant is informed thereof, and is permitted to amend his specification by making the description and claims to be clear of the precise references that the examiner has drawn attention to. Should the Comptroller be satisfied that the objections have been removed, he can accept the specification, but, on the other hand, if he is not so satisfied, in accordance with section 7, the applicant or his

agent can be heard, and unless the objection is removed by amending the specification to his satisfaction, may order a reference by name and number to the prior specifications to be inserted in the applicant's specification, by way of notice to the public.

### REFUSAL OF PATENT.

It has been no part of the duty of the Patent Office heretofore to refuse to grant a patent, provided the applicant inserted the necessary references in his specification to the anticipating specifications that the Patent Office had drawn attention to. Consequently, many worthless patents have been granted that the Patent Office knew to be absolutely and entirely anticipated, and the patentee was then in a position to allege patent rights against others who were, possibly, not familiar with the weakness of his specification, or who did not desire the costliness of resisting the claims of a patent in any action, even although they knew that patent to be bad. Under sub-section 4 of section 7 the Comptroller is now empowered to refuse to grant a patent altogether, if he is satisfied "that the invention claimed has been wholly and specifically claimed in any specification to which the investigation has extended."

Very considerable objection has been raised in some quarters to the granting of this new power to the Comptroller to refuse a patent. It has been urged that insufficient information would be considered by the Patent Office authorities for enabling them to arrive at a proper determination as to the narrowness of an invention that might be held by a Court to be good subject-matter for a patent. The force of this objection, however, is removed when it is remembered that any decision of the Comptroller is subject to appeal to the law officer, and, from the experiences of the past decisions of the Patent Office and the law officer, the author is of opinion that no injury, but a great advantage to inventors and the public generally, will result from this vesting of the right of refusal in extreme cases, where there is identity, in the hands of the Comptroller, for unscrupulous persons

will be prevented from defrauding the public and harassing industries by worthless patents.

#### CHEMICAL INVENTION.

Where the application has reference to a chemical invention, the Comptroller, before accepting the complete specification, may, under sub-section 5 of section 2, require that the applicant shall furnish typical samples and specimens, in order that the effect and scope of the claims that are made may be appreciated, and to prevent too broad a claim being made, such as would bring within its scope the whole series of substances or products as to which the applicant had no particular knowledge, but which it might be possible for him to so describe as to prevent subsequent experimenters and investigators from becoming possessed of the fruits of their investigation by the vague wording and indefinite claims that had been made in a prior specification pertaining to somewhat like chemical combinations or process. The samples and specimens that are to be furnished are not intended to be taken as those which can be referred to in the matter of museum-like products, but simply proofs, so that what the inventor seeks to claim can be definitely determined, and that the product he desires to claim as his own can, in effect, be made by him under the directions given in his specification. The specimens are not so much for the public enlightenment hereafter, but to enable the patent to be granted after the Comptroller has been satisfied that that which is sought to be patented by the patentee is in effect a practical process, and not a "dog-in-the-manger" kind of idea that would enable the patentee to harass the subsequent inventors and investigators who devised and produced substances that were not known or appreciated by the patentee at the time when he applied for his patent.

#### "ACCEPTANCE" OF THE SPECIFICATION.

Upon the examiner reporting favourably to the Comptroller, the specification is then "accepted" by him, and the specification is placed in the Patent Office for public

inspection, and the fact advertised by the Comptroller that the specification is open for opposition for a period of two months from the date of such advertisement. Within about three weeks from the publication or placing to the public view of the specification, printed copies are on sale of the specification and its accompanying drawings, at the uniform price of 8d. each.

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### CHAPTER III.

#### OPPOSITION TO PATENT.

DURING the two months following the advertisement of the acceptance of the specification, any person is at liberty to oppose the grant or the sealing of the patent upon the following grounds:—

(a) That the applicant has obtained the invention from the opponent, or from a person of whom he is the legal representative.

(b) That the invention has been claimed in the complete specification of a British patent published fifty years before the date of the application;

(c) That the nature of the invention or the manner in which it is to be performed is not sufficiently or fairly described and ascertained in the complete specification; or

(d) That the complete specification describes or claims an invention other than that described in the provisional specification, and that such other invention forms the subject of an application made by the opponent in the interval between the leaving of the provisional and the complete specification; but on no other ground.

Upon notice of opposition being given, and at the expiration of two months, the Comptroller shall hear the applicant and opponent either personally or by agents or counsel, and give his decision, which, however, is subject to appeal to the law officer.

It has been decided that a member of the public who may happen to be aware of a prior patent which com-

pletely anticipates the application of a later inventor, but who has himself no interest in such prior patent, cannot oppose the grant of any patent.

In the opposition proceedings, which are conducted before the Comptroller, and, unless an appeal is made to the law officer, decided entirely by him, after giving the applicant and the opponent a hearing, no account is taken of a pure infringement by one patent of another.

The rejection or the disallowance of an opposition to a patent does not prejudice the opponent's position if it be upon a matter of infringement, seeing that the Comptroller has no power to try infringements or general cases of equivalents, but has to decide simply upon the bearing of the grounds of opposition before mentioned. Costs can be recovered from proceedings conducted before the Comptroller, and the law officer may also allow such costs as he may consider necessary to cover the actual expenses of the hearing before him.

#### SEALING THE PATENT.

If no opposition is offered to the grant of a patent, or if the opposition fails, after a sealing fee of £1 has been paid, the patent is sealed with the seal of the Patent Office, and the date of the patent is that of the original application for provisional protection, or the date of the first application with the complete specification in the event of no provisional protection being sought.

Before 1878 all letters patent for inventions, as well as for other matters, were sealed with the Great Seal, but under the existing Act the seal of the Patent Office, which is in the form of a wafer seal, is impressed at the end of the printed letters patent.

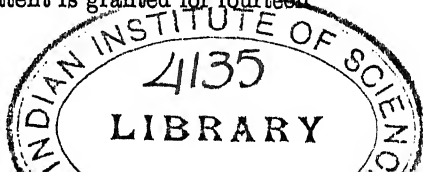
#### THE GRANT OF THE PATENT.

All patents are granted for fourteen years, dating from the day on which the application for the patent was made; and every patent when sealed has effect throughout the United Kingdom and the Isle of Man, but not throughout the Channel Islands.

Although the term of the patent is granted for fourteen

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years, the patent rights will cease if the patentee fails to make the prescribed payments for keeping the patent in force within the prescribed times.

### RENEWAL FEES.

At the expiration of the fourth year, dating from the application for the patent, and before entering the fifth year, the patentee is required to pay a renewal fee of £5 ; and on or before the end of the fifth year a further renewal fee of £6 ; and so on at the end of each year, the annual renewal fees increasing £1 per year in extent up to the end of the thirteenth year, when £14 is payable to cover the last or fourteenth year.

If by accident or other cause the fees are not paid during the prescribed time, the Comptroller may grant an enlargement of the time for making the patent. If the period of three months elapses before the fee is paid, then recourse was previously required to a special Act of Parliament to restore the patent rights by enabling the fees to be paid. This costly provision has been amended under the new Act, wherein section 20 enables the Comptroller to restore a patent that has become void owing to the accidental failure of the patentee to pay the prescribed fee. The advantage, however, that may have arisen to others who in the meantime presumed the patent had been intentionally abandoned by the non-payment of the fees, will be continued.

### EXTENSIONS OF THE PATENT.

Although a patent is never granted for a period longer than fourteen years, it may sometimes happen that this period has proved quite inadequate for the patentee to reap that personal benefit which the grant of the patent is intended to secure, and in such very exceptional cases an extension or prolongation of the grant may be obtained.

To secure this extension the patentee must show that he has expended large sums of money in perfecting the invention, which must be of sound commercial utility, and that he has not recouped himself sufficiently for the

outlay. A petition to the Court has to be presented, praying for a prolongation of the monopoly before the expiration of the period covering the grant of the patent. Books, papers, and all documents relevant to the question of the cost and profit of the patentee will be closely examined, and all foreign patents will be considered in the matter of deciding as to the profit or loss which may have arisen.

#### PATENTS OF ADDITION.

Under the new Patent Law it will be possible for inventors to obtain "patents of addition," or supplemental patents to original patents that have been previously granted them. These "patents of addition" or further patents must be in respect of any improvement or modification of the original invention. No renewal fees will be paid upon these additional patents, which will lapse or expire with the original patent. This valuable provision will be of great value in connection with engineering and other inventions concerning which improvements become necessary after the invention has been in public use for some little time. The value of this new matter, which is provided for by section 19, will be appreciated when it is remembered that the renewal fees in respect of each separate patent, had such been granted for each "patent of addition," would have amounted to a total of £95.

#### DELAYED OPPOSITION.

If, after a patent has been granted, any person discovers that he would have been entitled to oppose the grant of the patent had he been aware of such, or is the successor in interest of a person who was so entitled, he may, under the new section 26 of the Act, within two years of the date of the patent, apply to the Comptroller to revoke the patent on any one or more of the grounds upon which the grant of such patent might have been opposed.

This provision, although it brings into practice that which has never heretofore been recognised, the power of

the Comptroller to revoke a patent after it has once been granted, is only to be used in cases where the patent ought never to have been allowed to issue at all, and, seeing that the period during which the belated opposition can be exercised is but two years, no very extensive interference with the trade of the patentee is likely to result, as it is scarcely possible that an invention of importance under such circumstances would have become of great manufacturing value within two years of the date of its grant.

Any frivolous or malicious opposition to a patent, either before or after its grant, will be checked by the salutary powers given the Comptroller for awarding costs against the unsuccessful opponent.

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## CHAPTER IV.

### SURRENDER AND REVOCATION OF PATENT.

THERE has been in the past but one method of obtaining a release or revocation of a patent open to patentees, viz., that associated with proceedings before the High Court. Under section 26, however, a patentee may at any time, by giving notice in the prescribed manner to the Comptroller, surrender his patent, whereupon the Comptroller, after the proper proceedings, may make an order for the revocation of the patent.

An additional ground of revocation is provided under section 25 in connection with the granting of licenses or the unfair conditions that are attached thereto by patentees, the revocation being possible as an alternative to the grant of a compulsory license.

The grant of a patent for an invention operates to curtail the liberty of all subjects, other than the patentee or his licensees, from using, working, or making the invention, even should they of their own effort and by their own labour make the discovery themselves. The restriction thus imposed upon manufacturers and the public generally, in favour of the patentee, is warranted

by the assumption that the patentee is the true and first inventor, and that the subject-matter of the invention is novel and useful. The public are in effect restrained for a definite period, in order that the inventor may reap a reward for the new manufacture which he is considered to be introducing, and which he is instructing the public themselves to use by his specification, so that when the period of the patent has expired the common trade of the country may be improved by the free use then to be obtained of the invention.

From this restriction it follows that if a grant of letters patent is made for an invention which is in reality an old idea, or if the patentee is proved to be not the true and first inventor, or if the patent, from causes previously mentioned, is rendered invalid, then so long as the patent remains unrevoked an injury is caused to the public by the patentee enjoying an exclusive and personal monopoly to which he is not entitled.

To remedy the grievance which the public have against the owner of an invalid patent, provision has always existed for securing the cancellation and repeal of the patent grant. The original method of procedure by *scire facias* is now abolished, and the presentation of a petition to the Court has been substituted.

There are certain persons who are stopped or absolutely debarred from raising the question as to the validity of any patent in consequence of a good and fair license, agreement, or other interest which they may hold in the invention, but these circumstances should be considered when the conditions then pertaining to the granting and accepting of licenses are being prepared.

#### AMENDMENT OF THE SPECIFICATION.

A defective specification, whether from the fact of being deficient in descriptive matter, misleading in the instructions it professes to give, or too wide in its claims, is absolutely fatal to the validity of every patent. But the law provides for the benefit of patentees that amendment of the specification be made in certain particulars, so that a patent which would ordinarily

be void owing to the carelessness or ignorance of the patentee in the matter of the requirements of the specification, and the nature of the claims which he should have sought, may, by amendment of the specification in the hands of a skilled adviser, be made perfectly valid.

### THE RISKS IN AMENDING.

Although a specification can be amended, it must be understood that this amendment can in no case enlarge or extend the scope of the claims, or increase the ambit of the invention which is set forth in the specification, but the result will rather narrow or specifically limit the scope and strength of the original claims. Thus the original drafting of the specification, appearing perhaps somewhat of an easy task, becomes in point of importance a most difficult and studious matter if the patentee is to have any clear title to validity in the grant which is made him.

Any person may oppose the amendment, and the process connected with the opposition, hearing, and grant of the amendment is similar to that connected with the opposition to the original grant of the patent.

The functions of the explanations which will be permitted to be added to a specification in the form of an amendment are definitely required to be in strict accordance with the original statement set forth in the specification, and no words or meaning may be introduced which have arisen out of subsequently acquired information, experiment, or knowledge.

There will always be great difficulty in obtaining damages for any infringement which was committed prior to the date of the allowance of the amendment. The patentee will be simply able to secure that past infringements shall not be repeated, and an injunction will probably be granted, without damages or compensation for past losses which may have arisen.

### AMENDMENTS DURING A PATENT ACTION.

When a patentee finds during the progress of an action instituted by him that he has included some portion

of the non-essential part of his invention which is established as being old with other vital or most essential elements which are free from attack and admittedly new, he can apply for leave to amend his specification to the Court; or the judge may at any time order that the patentee shall, subject to such terms as to costs and otherwise as the Court or a judge may impose, be at liberty to amend his specification by way of disclaimer, but no amendment shall be allowed that would make the specification as amended claim an invention larger or different from the original claims.

No damages can be recovered in any action in respect of infringements committed before the disclaimer, unless it is proved to the Court that the original claims were framed in good faith and with reasonable skill and knowledge.

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## CHAPTER V.

### LICENSING AN INVENTION.

WHEN a patentee is offering his invention to a manufacturer too great care cannot be bestowed upon the first model or pattern which is to be submitted, for, even should the principle be properly shown, an ill-finished and badly-constructed sample will tend to reduce the royalty which will be secured. Printed descriptions are positively disadvantageous on the other hand, as the suggestion is conveyed that the invention has been offered to many persons, and no manufacturer is anxious to undertake that which others have declined. Personal statements made by inventors respecting their own inventions are necessarily prejudiced, and only too often this prejudice deters large firms from giving any consideration to "worrying inventors."

A license to use an invention is the grant of a right or a conditional interest from the patentee to the licensee, and during the time that the license continues it removes the prohibition contained in the patent as against the

licensee, and enables him to enjoy the whole or a part of the privileges which the patent confers.

A license may be for a district, for a country, for a period, or for the full term of the grant, with an exclusive conditional right to make, vend, and use the said invention.

### CONDITIONS OF A LICENSE.

There are many patents which, when granted, are found to seriously injure other patents which have had a good sale up to the introduction of the improved articles. When such articles are made by firms who are acquainted with the fact of the new invention being introduced, a feeling of insecurity prompts them to make inquiries respecting a sole license for the new article, and this license when granted enables them to decline to injure their own trade by producing any of the new and improved appliances, while they are safe from the possibility of others producing them against their own articles. The license is taken, but it is never worked, and no one else can work the patent. To prevent such outrageous anomalies, and to ensure that the license shall not be allowed to remain a dead letter as against the patentee, certain clauses and conditions are imperatively necessary; while on the other hand clauses to protect the maker from having to pay royalty in the event of any patent action against a third person proving the patent to be invalid should also be inserted for enabling the license to be determined. A license to manufacture an article is an authority also for the manufacturer to sell, without the express consent of the owner. The licensee cannot assign or transfer his license to any other person, or empower other persons to make for him, unless the owner has expressly provided for that in the terms of the license; it is a personal matter, and a personal transfer of interest from the patentee to the manufacturer alone. All licenses may be registered in the Register of Patents, at the Patent Office, London.

A verbal agreement between a manufacturer and a patentee may be good if it has continued for any length

of time, and if royalties have been regularly paid in accordance with the terms of the understanding. An agreement for a license requires to be stamped in the same manner as a formal deed for the license.

No license can be registered respecting any provisional patent, but an agreement to license can be made between the parties, which can be subsequently embodied in a formal license when the patent has been sealed.

The consideration for the grant of a license is sometimes an immediate cash payment; and on this fixed payment thus made, or on the minimum royalty which it is stated shall be paid yearly, an additional stamp duty beyond the ten shillings deed stamp is required as an *ad valorem* duty.

### ROYALTY.

The royalty to be paid by the maker is usually stated as so much per centum on the actual price the article is sold for, or so much per article; and these payments should be provided for by fixing certain definite quarterly dates upon which the statements as to all sales, manufactures, and royalties should be delivered by the licensee to the owner or patentee. Right of inspection of books to verify the accounts, and correct numbering and marking of all articles, should be provided for. The licensor should be empowered to cancel or revoke the license on failure of payment or breach of any of the covenants.

The grant of a license does not of itself create a partnership in the patent between the patentee and the licensee. The patentee or owner should keep the payments made in order that the patent shall be maintained, and a clause to this effect should be inserted, giving, however, the licensee power to himself pay the fees out of future anticipated royalties, should he elect to do so. Unless a special clause is inserted in the license, the licensee is bound to pay royalties as long as the patent exists when working under the license, even though the patent has been held to be invalid against some other manufacturer. Until the patent is revoked the license holds good against the licensee.



## FURTHER IMPROVEMENTS.

Much trouble arises from inventors introducing improvements upon original patents, and then seeking new firms as licensees.

To prevent this, a covenant should exist in the license, whereby all future improvements shall be freely communicated to the original licensee.

## UNFAIR LICENSES—RISKS.

In the licenses that have been previously granted in connection with many American and other inventions for use in England, conditions have been attached requiring the licensees to purchase other articles than were covered by the patent, from the patentee or his nominee, and also requiring that exclusive dealing should continue with the patentee for a period over a number of years not limited by the term of the patent. These unfair conditions under section 38, will hereafter become void, and the insertion of any condition such as would render the license void will make it a ground upon which the patent can be revoked, and upon which any infringer can successfully resist an action for infringement by the defence that he will then be able to set up by pleading the fact that an unfair license has been granted to another person and trade thereby restrained.

The somewhat drastic provision that has been introduced in the new Act, whereby the life of a patent can be attacked by any infringer because of an alleged unfair or improper condition that may exist in another person's license with which he may have no interest, will render the drafting of any license to use or work any patent a matter of extreme difficulty for the inexperienced. It will be imprudent, if not practically unsafe, for any license to be drafted or granted unless an experienced counsel's opinion is first taken thereon for the protection of the patentee and licensee alike. While the terms of section 38 are very definite as to what shall not be inserted in a license as the sole conditions for royalty

payment, it will still be possible for a friendly arrangement satisfactory alike to the patentee and licensee to be made wherein an option is given in the license of a cash or other purchase consideration by way of an alternative to the other possibly questionable or attackable terms. The intention of the framers of the section was to prevent a patentee or a trust acting on the part of a patentee, from getting a grip or any prejudicial control over the business of the licensee, such as would restrain or interfere with the trade for the benefit of the patentee alone against the interests and free and fair action of the community as a whole. If this intention is appreciated aright, the effect of any condition inserted in a license may be interpreted possibly in its true relation to the terms and provisos of the section.

#### ASSIGNMENTS.

An assignment or absolute transfer of all interest in a patent must be by deed, and it must be registered at the Patent Office.

No particular form of assignment is required to constitute a valid transfer, and the ordinary rule of law as to favourable interpretation of deeds will be applied.

When a patent has been assigned, and the names of the new owners have been duly entered upon the register, they may apply for leave to amend the patent if such should be found necessary, and they are fully entitled to all the benefits to which the original patentee was entitled.

A mortgage may be obtained upon a patent, but it is desirable for the mortgagor to insist on the mortgagee entering into a covenant not to seek leave to amend the specification or drawings without the mortgagor's written consent.

A purchaser, without a warranty from an assignor, in the absence of fraud, is bound to take the patent as it stands, with its faults, if it has any.

If a bankrupt, before obtaining his certificate of dis-

charge, obtains a patent, it will vest in his trustee, for the benefit of his creditors.

If a patentee or an assignee is declared bankrupt, the patent vests in the trustee of his bankruptcy estate, who therefrom becomes entitled, for the benefit of the creditors, to bring any action in respect of any infringement, and generally to do that which had been the privilege of the patentee himself to do.

### COMPULSORY LICENSES.

If, on the petition of any person interested, it is proved to the Board of Trade that by reason of the refusal of the patentee to grant licenses on reasonable terms, and that the patent is not being worked in the United Kingdom, or that the reasonable requirements of the public with respect to the invention cannot be supplied, or that any person is prevented from working or using to the best advantage an invention of which he is possessed, then the Board may order the patentee to grant licenses on such terms as to amount of royalty, security for payment, or otherwise, as they may deem just, and they may enforce any order thus made by mandamus.

When a patent is not being worked in this country, but the patented articles are being imported from abroad, the petition may be referred to a Court, and an order may be made revoking the patent, under section 24.

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## CHAPTER VI.

### INFRINGEMENTS OF PATENTS.

THE monopoly and privileges granted to a patentee, in the specific terms which are set forth upon the letters patent most clearly, constitute rights which no other person can appropriate in any manner without risk of legal proceedings being taken for the infringement committed.

Ignorance of the existence of a patent is no answer to an act of infringement, and as there is no absolute necessity for a manufacturer to mark or brand his patented articles with the word patent, or by any other way to proclaim the protection that is existing, if he is content to obtain an injunction against any infringer, it behoves every person who may be desirous of copying any new article to institute a search, or make inquiries respecting the ownership of the original, before commencing to manufacture, use, sell, or vend the article. If the year and number of the patent, however, is placed on every article, the patentee will the more readily obtain damages as well as an injunction, as he will then be able to prove knowledge of his patent by the infringer, who may have seen his article before copying or trying to evade it.

#### WHAT CONSTITUTES INFRINGEMENT.

A patent will be infringed by any person manufacturing articles in accordance with the terms or description of the means set forth in the specification of the invention, and by an imitation or an equivalent thereof.

Putting the invention into effect or using it, or using an imitation of it, or by putting the pith and marrow or substance of the invention into use, is an infringement.

Selling or otherwise dealing in the article which has been manufactured by a person without the license of the patentee, or offering for sale, is an infringement, very commonly and oftentimes innocently practised.

Making for personal use, or vending imitations of the patented articles, making obvious modifications of the articles, or employing the same essential features in a process or a system of manufacture, constitutes an infringement.

The importation into this country of goods manufactured abroad by a process or by means patented in this country constitutes an infringement of the patent. The use in this country of articles made abroad, which are patented only in this country, even though the

articles are for again exporting, and not for actual sale in this country, has been held an infringement of a patent.

Before making any suggestion or charge of infringement against any person, it is most essential that the patentee shall have the subject-matter and general novelty and sufficiency of his patent specification rigorously examined by an expert, for should the infringement necessitate legal proceedings, the whole title and character of his patent rights will be seriously attacked by the defendant in any action.

To establish proof of an infringement the patentee must show that the acts complained of constitute an interference with his privileges, and that his rights are prejudiced by the continuance of the alleged infringement, and under the new law it is desirable to prove guilty knowledge of the patent.

### COMBINATION PATENTS.

Very few patents comparatively are without combinations of known parts producing new results, and it is oftentimes a matter of difficulty to decide as to how much of the combination used will constitute an infringement. A combination may be infringed in three ways:—

1. By using the whole or substantially the whole of the combination.

2. By using the pith and marrow of the combination, and omitting or varying some part to destroy the actual resemblance.

3. By using a new and material part of the combination.

The patent for an entire combination for a process gives protection to each part thereof that is new and material for the process, although there may be no claim or express claiming statement made as to the particular parts.

On the other hand, the use of a subordinate part which is not new, or the use of a combination of parts to produce the same result in which a subordinate part of a patent is employed, while the mode of operation is

different and distinct from the patented combination, is not an infringement.

If a patentee in his specification claims the entire arrangement and specific combination of parts set forth, and then also claims in subsequent claims certain parts which he specifies as the subordinate and subsidiary parts, these subsidiary claims may narrow his patent, as they may be held to exclude the possibility of the other parts employed from being considered as novel parts.

Generally stated, an infringement of a combination claim in a machine is committed by a person who uses the same means in substance as a patentee of the machine, though he varies the form of the machine. An obvious evasion or a mechanical equivalent is held to be colourably imitating an invention, as in the celebrated case of piracy of the steam engine, in which the judge said: "Where you looked for the head you found the feet, and where you looked for the feet you found the head; but it turned out that he had taken the principle of Boulton and Watt's engine."

#### PATENTS FOR A PROCESS.

Although a patent cannot be validly obtained for a mere principle, yet the process or system of manufacture by which a principle may be carried into effect can be protected by patent, and any servile imitation or colourable evasion of the process described will be treated as an infringement.

Several patents or patents of addition will be valid for several methods of obtaining the same object, provided these methods are not identical.

If the specification merely recites the objects of the invention, and does not point out clearly the mode or method by which the patented process is to be performed so as to successfully attain the object in view, it will be a recital of the principle only, and the patent will be invalid. When a patent is taken out for a certain process of arriving at a result, which result is well known at the time, any other person may secure a patent for another process, or he may employ another dissimilar process

without infringement. But where the result is a new one, and there is one process described by way of example for arriving at that new result, the patentee is entitled to protection against other processes for the same result.

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## CHAPTER VII.

### WORKING IN ENGLAND.

THE grant of a patent being declaredly for the benefit of the industry rather than for a reward for the individual, the new requirements of the Patents and Designs Act, 1907, are so drafted in sections 24 and 27 as to oblige the patentee to meet the British demand for his invention by manufacturing it in the British Isles instead of simply importing therein the articles made abroad.

The conditions of section 27, which have reference to working, are applicable to all patents, so that the English patentee cannot get his article manufactured mainly or solely abroad and then sell it in Great Britain without the serious risk of some person starting to make for himself, and thus infringing his patent after four years from its date, and then pleading, under section 25, that the patent is liable to revocation, and is consequently invalid, in consequence of the manufacture being one carried on mainly abroad.

It is probable that the home working of inventions will be greatly expedited under this fear of a defendant being able to plead foreign manufacture, should he be attacked after four years have passed since the patent was applied for. The provision of section 27, having reference to application to the Comptroller to revoke a patent for non-working in this country, only apply to patents that are four years old. It will be for the petitioner to show that there are no satisfactory reasons why the patented article or process is not so manufactured or carried on to other "an adequate extent" in the United Kingdom.

In connection with foreign patentees the provisions of the working section 27 may be used to secure, under the International Convention or by treaty, reciprocal terms for non-working in countries where the citizens of each country agree not to compel working in the like other convention countries.

The Act of 1907 was intended to institute, and in effect is proving to have secured, a complete chapter of improvements long since desired and advocated; but by the exigencies of political controversial methods, it has only been publicly acclaimed in reference to the alterations instituted relative to the working section affecting those British Patents whether granted to natives or foreigners that had hitherto, in the precise words of the previous Act of 1902, been "manufactured exclusively or mainly outside the United Kingdom."

That such an advertisement as to the possibility of revoking patents was likely to induce and provoke attacks upon those patentees who had been acting the part of dogs in the manger, or injuring traders by their unfair methods, was possibly to be expected; but that it would stir up a great campaign, or create a desire on the part of the British trader to remove a large number of patents from the register, or to harass patentees, the author always privately and publicly disavowed and discredited. It is of some satisfaction, therefore, to note that his opinion has now been completely justified and confirmed by the recently issued official report of the Comptroller General of the British Patent Office.

#### THE RARITY OF REVOCATION SUITS.

The number of British patents over four years old that were actually in force on the official register, and thus open to attack if non-worked when the Act became operative on August 28, 1907, was over 26,000; and the number of such patents that were actually assailed by petitions for revocation presented up to the end of 1908, after some two years of much-



advertised opportunity, was only thirteen. Thus if taken on a popular system of computation, it appears that less than one patent out of 2,000 was assailed on the ground of not being worked in the United Kingdom.

The liability of patentees to attack for working solely abroad would appear to be greatest from foreign manufacturers desiring to obtain the benefits of the English market rather than from the British manufacturers seeking to destroy the patents. It would appear that the manufacturer residing abroad in a country where no patent has been granted for the same article cherishes a desire to export to the British market when he finds that his rival without a patent at home actually possesses a patent in Great Britain which thus gives him the monopoly of the market there which he is maintaining by the importation of his own foreign-made productions.

#### REVOCATION AND IMPORTATION.

From evidence that has been presented to the Patent Office in suits for revocation, it is clear that there has been great eagerness in connection with the majority of cases upon the part of foreigners from one country where there was no patent monopoly to break down the British patent so that they could freely import from that country into British markets, even when there was an expressed intention upon their part not to make or work the invention in the United Kingdom.

#### LICENSES *v.* OPEN COMPETITION.

This well-established result of the Act should conclusively prove to those that have alleged that the Patents Act of 1907 was intended to solely protect and bolster up British manufacturers that such was not the intention of the framers of the Act, and, further, that there is not in existence a desire on the part of British manufacturers or British patentees to destroy foreigners' patents in their country. It can

be shown, on the contrary, that there is instead a desire on the part of the home manufacturers to secure on proper terms from the patentees sole licenses to work such patents alike for their interests and for the interests of those owning the patents. It should be remembered that it is undoubtedly to the greater profit and advantage of a British manufacturer to become a licensee where he will be free from general competition and be under the protection of the patentee's license monopoly, than to be one of many making in open competition and against others too who could by various devices reduce the profits or cut the prices that could be obtained from such open unlicensed manufacture.

It is manifestly of greater advantage to a manufacturer to pay royalty to a patentee and preserve to himself a limited monopoly during the life of the patent, than to endeavour to destroy that monopoly and make the invention public property where he would be at no greater advantage than any other person who had not gone to the expense of seeking to break down the patent by securing its revocation.

#### REASONS AND PROOFS.

The experience of the Patent Office, obtained during the hearing of the petitions instituted for revocation under section 27 of the Act, has made it desirable to further protect patentees against wanton attacks by rival traders, who might possibly seek without good grounds to revoke patents. Consequently, revised and amended rules of procedure have now been issued requiring the person petitioning for revocation to set out very fully in a declaration his *bona-fide* reasons for bringing the action, and to furnish the proofs relied upon for his case when presenting the petition. The patentee is further protected by being afforded ample time to answer or file any criticism or comment upon such statements before the petitioner will be permitted to be heard by the Comptroller.

## NO OFFICIAL OR AUTOMATIC REVOCATION.

To reassure those foreign patentees who have been misled by the non-technical press into considering their British patents to be in serious jeopardy, the fact cannot be too well remembered that no official action of any kind is taken upon the part of the Government authorities to revoke or render a British patent void; and that, as only *one patent* out of every 2,000 was attacked during the period when the greatest publicity was given to the possibility of such being legally assailable, the value of a British patent has not depreciated, but has actually increased owing to the greater desire to obtain a license which has been created or fostered by the new Patents Act of 1907.

## CONFIDENCE OF PATENTEES.

The following figures abstracted from the official Report of the Comptroller General of the Patent Office for 1908, demonstrate that the confidence of foreign inventors in the value of a British Patent appears not to have been disturbed since the Act became operative from August 28, 1907.

## BRITISH PATENTS GRANTED TO

Residents in	1908	1907	1906	1905
U.S. America .....	2,819	2,792	2,595	2,505
Germany .....	2,516	2,608	2,091	1,956
France .....	822	753	769	805
To all Foreigners .....	7,522	7,373	6,503	6,255
Total Patents to British and Foreign Patentees.....	16,284	16,272	14,707	14,786

## POINTS IN DECIDED CASES ON "WORKING."

The manner in which the working requirements of Section 27 are likely to be interpreted can be appreciated from the following summary of the decisions that have been given upon the leading cases already adjudicated upon.

*Patentee doing his Best.*—Mr. Justice Parker, in *re* Bremer's Patents, stated that "the Act of 1907 was never meant to penalise want of success where the patentee had done his best to fulfil the obligation arising under the Act of manufacturing in the United Kingdom. . . . It is by no means an easy thing to establish an industry for the first time. Both managers and workmen must buy their experience."

*Sufficient User.*—In the proceedings for revoking Patent No. 14146/01, it was held that while the evidence established that one particular part of the patent was not made or used in this country or abroad, the process was being worked by a simpler apparatus not covered in the patent. As the patentees were prepared to grant licenses to use their invention, the patent was not revoked and costs were awarded against the petitioner.

*Immaterial Parts.*—The patentee should not be called upon to manufacture any mechanism or machine that he had not specifically described and claimed in his specification. (Johnson's Patent No. 8401 of 1903.)

*Slight Demand.*—At the date of the application to revoke Patent No. 3677 of 1898, one machine had been made in the United Kingdom, the second had been commenced, while a third had been started upon. The actual demand did not exceed two machines per year while the manufacturers employed by the patentee could turn out twelve machines per annum if necessary. Held that this was sufficient manufacture to meet the known demand. Costs were awarded against the petitioner.

*Negotiations Pending.*—In *re* Patent No. 28807 of 1904, foreign manufacture was admitted, but it was urged that there were satisfactory reasons for this as negotiations for the sale of the patent had been commenced within the first four years of the patent, and as a result

the patent had been assigned to a British Company. Only a few of the articles were made in 1908, but the owners of the patent were in a better position to subsequently manufacture to a full extent.

These reasons were considered satisfactory and costs were awarded to the patentee.

*Neutral Markets.*—In the hearing of a case against Patent No. 5368 of 1903, it was urged that no attempt to start manufacture or working had been made until March, 1908, and that no satisfactory reasons could be given. The patentees urged that there was no obligation upon them to show any substantial manufacture here until a demand for the patented article or process had arisen or been created, but the Comptroller, when revoking the patent, decided that this argument was fallacious as the consideration of the adequacy of manufacture depended to some extent on the demand existing for the article here or in neutral markets and that it did not follow that if there was no demand existing there was no obligation on a patentee to start an industry. If there is manufacture in foreign countries and there is a demand for the article or process abroad, the patentee must make an effort to create a demand in this country. It was contended that the article was complicated, but there was no evidence to support the contention that it could not have been made in England.

*Substitution of Parts.—Insufficient Working.*—Patent No. 26519 of 1896 (Wilcox & Gibbs' Sewing Machine), was revoked in consequence of the whole machine being imported from America, and then before being sold in England a few parts were taken out and others substituted in their place that were made in England of a stronger kind or of a particular design to suit the purposes for which the machine would be put. The substituted parts, however, were very few in number, as compared with the other patented parts of the machine. It appears from the evidence that accessories not the subject of this patent were manufactured in England and sold with the machine, but that no patent was granted in Germany, and the applicants seeking to revoke the patent were those concerned in German works desirous

of selling foreign-made sewing machines in the United Kingdom made in such a manner as would, if the patent existed, constitute an infringement thereof.

It was decided that no satisfactory reasons had been given why the article had not been manufactured in the United Kingdom, and as there were but two years for the patent to run, revocation was ordered forthwith, owing chiefly to the fact that the patentees had stated in their evidence that it would be between five and ten years before the Company could be in a position to completely make the machine in England.

*Satisfactory Reasons for Delay.*—In deciding not to revoke Patent No. 4391 of 1904, but to give further time to enable the patentee to comply with the provisions of the Act, the Comptroller stated that the failure of the efforts of the patentee to sell or license his process had been due to the conservatism of English manufacturers and not to negligence on the part of the patentee. In sending a circular to manufacturers, the terms of the sale or license set out that the services of the inventor would have to be engaged so that the price asked for was not for the patent alone but for the personal skill of the individual. This combination of patent and personality was held to be unwise in the interests of the patentee.

*Advertisements for Sale of Patent.*—In revoking Patents Nos. 6455 of 1900 and 22139 of 1900, the value of advertisements and circulars was considered by the Comptroller and also by the Judge as being negligible.

"It seems to me impossible to hold that a patentee can relieve himself from the duty of manufacturing in this country by the mere insertion at any time of a few advertisements and the sending round to manufacturers of a few circulars, to which no replies are received. I am not surprised to find that no one has been willing to buy or take up a license."

The fact of no one being found willing to buy or take up a license of manufacture does not prove that there is no demand for the patented article.

*Consent to Revocation.*—In cases where petitions have been presented for revocation and the patentees had forthwith signified that they did not propose to contest

the application, the patents were revoked without costs being ordered against the patentees.

*Adequate Extent.*—In revoking Patent No. 26519 of 1896, the words, "to an adequate extent" were stated to be taken from paragraph 11 of the first section of Article I. of the German Patent Law of April 7, 1891, which provides that patents can be revoked if the owner neglects to put the invention into practice within the realm to an adequate extent, or at any rate to do everything that is necessary to ensure such carrying out of the invention.

"If the essential features of the patented article are not manufactured in the United Kingdom to such an extent as to substantially satisfy the demand here, but are imported from the United States, then the patented article is not manufactured to an adequate extent in the United Kingdom."

*In re* Patent No. 5638 of 1903, "the consideration of the adequacy of manufacture in this country does no doubt depend to some extent on the demand existing for the article here or in neutral markets, but it does not follow that if there is no demand existing there is no obligation on a patentee to start an industry here. The patentee must make an effort to create a demand, and the establishment of an industry will in itself help to create in many cases a demand for the article or process in question."

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## CHAPTER VIII.

### THREATENING LEGAL PROCEEDINGS.

THE procedure in respect to calling attention to the supposed infringement of any patent by the patentee should be a matter of extreme care, as the Patent Act provides most distinctly for injury which may arise, or which may be assumed will arise, from the issue of such threatening letters, circulars, or general public notices. The issue of a general circular, warning the public against

purchasing articles of a certain kind other than through the agency of the patentee, may be shown to have caused loss and injury to other traders sufficient to entitle them to damages against the issuer of such notices.

The first letter or communication alleging infringement should therefore be issued with a full knowledge of all contingencies which may be expected, and legal advice should always be sought at the outset of any communication respecting infringement.

Section 36 of the Act of 1907 provides that: "Where any person claiming to be the patentee of an invention, by circulars, advertisements, or otherwise, threatens any other person with any legal proceedings or liability in respect of an alleged manufacture, use, sale, or purchase of the invention, any person or persons aggrieved thereby may bring an action against him, and may obtain an injunction against the continuance of such threats, and may recover such damage, if any, as may have been sustained thereby, if the alleged manufacture, use, sale, or purchase to which the threats related was not in fact an infringement of any legal rights of the person making such threats. Provided that this section shall not apply if the person making such threats with due diligence commences and prosecutes an action for infringement of his patent."

Threats as to future acts which are to be or which may be done are not threats against which damages would be granted; but threats about actions which have been done are actionable.

Threats are held to be damaging that are conveyed by a circular, an advertisement, a private letter, an interview, or by correspondence, even when such correspondence is conducted without prejudice.

A solicitor's threatening letter is sufficient ground for an action, and any threat made in a letter which has never been withdrawn is held to be continued.

The person threatened, or any other person who may be aggrieved by the threat, may seek a remedy either by an action to recover damages or by an injunction against the continuance of the threats.

Due diligence in commencing an action following up the threatening notice is established if an action is



brought within three months after the threats have been complained of.

#### COMMENCEMENT OF ACTION.

No person can take any proceedings in respect of infringements which have been committed before the publication of his complete specification, and until letters patent have been sealed and actually granted to him.

Where a number of persons are known to be infringing, it is a difficult matter for the patentee as to which one shall be proceeded against, seeing that, even should he be completely successful in the one case selected, the issue does not in any manner affect the others beyond leading them to understand what may result against them should another action be instituted.

A course of conduct suggested by Vice-Chancellor Wood meets the difficulties when adopted: "After getting information of case after case of infringement, the patentee might select that which he thought the best in order to try the question fairly, and proceed in that case to obtain his interlocutory injunction. He might write at the same time to all the others, and say to them, 'Are you willing to take this as a notice to you that the present case is to determine yours? Otherwise I shall proceed against you by way of interlocutory injunction; and if you do not object on the ground of delay, I do not mean to file bills against all of you at once.'"

#### NO NOTICE REQUIRED.

A patentee is not obliged to give notice to any person that he proposes to take any action against him, but he may apply for an injunction as soon as he is aware of his patent being infringed; and he is not required to cease or withdraw any proceedings upon the defendant or the infringer admitting and promising not to repeat the infringement.

An exclusive licensee cannot bring an action for infringement without joinder of the patentee; but a

patentee who has granted an exclusive license of his patent, without having actually assigned it, may bring an action without joining the licensee.

The defendant in an action is the person actually infringing, the contractor who uses, not the architect, or engineer who gives the instructions. Masters, however, are responsible for infringements committed by their workmen, notwithstanding such infringement may be in contravention of their orders; but the servant can be proceeded against as well as the master, and may be made personally liable for costs. The owner of a building or machine may be proceeded against to prevent the use of that which is alleged to be infringed, as well as the builder or firm constructing or supplying that which is complained of.

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## CHAPTER IX.

### APPLYING FOR INJUNCTION.

WHEN a patent has been infringed, the owner or the patentee has a choice of the manner in which he will protect his rights. He can, if he is anxious to give his infringers trouble, and cause them to at once recognise his power, apply for an interlocutory injunction to restrain them from continuing to infringe his patent until the trial which he proposes to bring for more fully establishing his interests and securing damages for the injury caused him by the infringement. If he is content to have the action tried in the ordinary way, in either the Chancery or the King's Bench Division of the High Court, without consideration being more particularly given to the infringement which proceeds while he is establishing his right, he causes

### A WRIT

to be served upon the defendants, having an indorsement thereon stating that the plaintiff's claim is for damages for the infringement of his patent, and for an injunction

to restrain the defendant from infringing the plaintiff's patent. There may be also further claims indorsed on the writ for damages for such infringement, or for an account of all profits derived by the defendant from such infringement, for delivery up to the plaintiff or the destruction of all articles in possession of the defendant made in such infringement, and for costs.

### INTERLOCUTORY INJUNCTION.

Where a patent has been in existence and used for some lengthened period, generally speaking beyond three years, the assumption of the court is that, the patent not having been attacked during that period, the owner is entitled to the protection of the court in order to restrain the infringement until such time as the validity of the patent has been established in a court of law, and an interim injunction will be granted the plaintiffs. Lord Lyndhurst held "that there may be considerable doubt as to the validity of a patent; still, if there has been a long exclusive enjoyment, the doctrine of the court is that an injunction shall go to protect the patent until the question of its validity is duly determined at law."

In a more recent decision it was held that if the patent is on the face of it so hopelessly bad as to be impossible of support, the court will consider before granting an interim injunction. The court will also consider the degree of convenience or inconvenience to the parties which may be caused by granting or refusing the injunction. In certain cases an injunction, if properly granted, might cause infinitely greater mischief to the defendant than the delay or refusal to grant it would cause to the plaintiff, and in such a case the legal right and absolute infringement must be proved beyond all question of doubt before an interlocutory injunction will be granted.

It is "part of the duty of the court to protect property pending litigation, but when it is called upon to exercise that duty the court requires some proof of title in the person who calls for interference. In the case of a new patent this proof is wanting; the public, whose interests

are affected by the patent, have had no opportunity of contesting the validity of the patentee's title, and the court, therefore, refuses to interfere until his right has been established at law." If there has been any acquiescence by the plaintiff in the wrong of which he complains, or if there has been unnecessary delay in making the application, an interlocutory injunction will be refused.

### REQUIREMENTS RESPECTING PROCEEDINGS.

In an action or proceeding for infringement of a patent the plaintiff must deliver with his statement of claim, or by order of the court or the judge at any subsequent time, particulars of the breaches complained of. The defendant must deliver with his statement of defence, or by order of the court or a judge at any subsequent time, particulars of any objections on which he relies in support thereof. If the defendant disputes the validity of the patent, the particulars delivered by him must state on what grounds he disputes it, and, if one of those grounds is want of novelty, must state the time and place of the previous publication or user alleged by him. At the hearing no evidence will, except by leave of the court or a judge, be admitted in proof of any alleged infringement or objection of which particulars are not so delivered. Particulars may be from time to time amended by leave of the court or a judge.

On taxation of costs regard will be had to the particulars delivered by the defendant, and they respectively will not be allowed any costs in respect of any particular delivered by them unless the same is certified by the court or a judge to have been proven, or to have been reasonable and proper, without regard to the general costs of the case.

The court or a judge may, on the application of either party, make such order for an injunction, inspection of accounts, and impose such terms and give such directions respecting the same and the proceedings thereon, as the court or judge may see fit.

The court or a judge may certify that the validity of

the patent came in question ; and if the court or a judge so certifies, then in any subsequent action for infringement the plaintiff in that action, on obtaining a final order or judgment in his favour, shall have his full costs, charges, and expenses, as between solicitor and client, unless the court or judge trying the action certifies that he ought not to have the same.

#### STATEMENT OF CLAIM.

The statement of claim must contain an allegation as to infringement in general terms, yet sufficiently clear to justify the remedy asked ; and must not set out a separate and distinct cause of action to that indorsed on the writ.

The form of statement, which should be prepared by a barrister-at-law, is commonly as follows :—

The defendant has infringed the plaintiff's patent, No. 14,084, granted for the term of 14 years, from the 21st May, 1880, for certain improvements in the manufacture of iron and steel, whereof the plaintiff was the first inventor.

#### THE DEFENCE.

There are two very generally adopted main grounds of defence set up in answer to the particulars of breaches ; and the defendant, when delivering his defence and particulars of objections on which he relies, will probably deny that he has committed any infringement of the plaintiff's patent right, and he may also deny that the plaintiff has any title to the privileges of his claim by reason of the invalidity of the patent on one or more grounds recited. A new defence may be set up under sections 24, 25, and 27 for unfair conditions in any license, or for working solely abroad.

#### PARTICULARS OF OBJECTIONS.

The defendant is required to furnish with his statement of defence detailed particulars of objections to the plaintiff's claim against him, and these particulars

must recite with greater detail and in precise terms every objection which he intends to urge against the patent, so that there may be no surprise of the plaintiff at the trial. The defendant is not precluded from bringing forward any number of objections, but these must be stated with precision before the trial in the particulars he furnishes. Very commonly the particulars will contain some or all of the following objections:—

1. That the defendant did not infringe the letters patent.
2. That the plaintiff was not the true and first inventor.
3. That the alleged invention was not a new invention.
4. That the alleged invention was not proper subject of letters patent.

5. That the alleged patent was for a principle only, and not for any new method or manner of manufacture.

6. That the alleged invention was not useful.

7. That the alleged invention does not produce the effects described in the specification, and that the specification does not particularly describe and ascertain the nature of such alleged invention.

8. That the alleged invention was generally known to prior to the date of the letters patent.

9. That prior to the date of the letters patent the alleged invention was in public use at , in the year , and in the manner following.

10. That the alleged invention and the several parts thereof were, prior to the date of the said alleged letters patent, published in the United Kingdom by

11. That the alleged patent is invalid by reason of unfair conditions in a license granted thereunder to

12. That the alleged invention is invalid by reason of the manufacture of the patented article mainly abroad.

The framing of the particulars of objections, and the general conduct of either the plaintiff's or the defendant's case, is a matter which a patentee or the manufacturer cannot possibly undertake himself. The

counsel and solicitor, with the competent technical patent expert, should always undertake these duties.

The measure of damages which the plaintiffs may recover is the loss sustained, or likely to be sustained, by him through the infringement; but if the profits made by the infringer are claimed, then damages in addition will not be granted.

When a person has in ignorance of a patent committed an infringement, he should offer to submit an account to the plaintiff, and to pay all costs incurred before an action is brought, or as soon after as may be possible to him. If this is done, the court will probably in its discretion let the innocent offender off costs, or the costs will be very much reduced. The patentee has, however, still the right to insist upon a perpetual injunction being made which will restrain the defendant from further infringing his patent. Upon the granting of a perpetual injunction the defendant must give full particulars as to profits made, together with the number of machines or appliances made, and the names and addresses of the persons to whom such have been sold.

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## CHAPTER X.

### HOW TO DISPOSE OF A PATENT.

THERE are many thousands of patents granted annually which never get beyond the inventor's immediate personal circle of acquaintances, and which utterly fail in bringing him substantial reward. The flooding of the manufacturing districts by circulars and appeals from needy and adventurous persons, setting forth the large fortunes realised by the inventor of this and that novelty, is but one portion of one side of the polygon enclosing all inventions within its area.

There are unscrupulous persons whose business, obtained chiefly by advertisement, apparently depends upon having one transaction with one client, and then

waiting for another new client, or victim, to take the place of the disappointed one, who has decided that as the only person who has made any profit out of his invention is the individual who received his original application fee, he will not proceed any further with the patent. On the other hand, there are a few manufacturers and others desirous at all times of taking up new articles and introducing new inventions in order to secure partial monopolies to assist them against the ever-increasing competition which accompanies the usual common course of trade concerned with the production and sale of ordinary articles.

### WHERE TO Go.

The patentee has two courses open to him on securing his patent, either of which will secure the maximum of comfort and convenience with the minimum of expense and personal trouble. But at the same time, the most favoured course, viz., to try and dispose of his invention in his own way and by his own methods, is generally found to result in loss, anxiety, and ultimate abandonment of the whole matter.

The private inventor, knowing nothing of the particular industry or the particular district which will be affected by his invention, makes a great mistake in attempting to manufacture himself. He finds, when too late, that the easiest part of his business is to manufacture and produce the article, while the difficult and practically impossible path is that which will bring the orders for the goods when made. Any one can make, and few only can secure a sale when made.

The domestic articles common to every household should never be manufactured by an inventor knowing nothing of the works and warehouses where the articles he has improved upon are made and sold from; he should rather seek out those interested in the actual manufacture, or those able to sell the old form of



goods. Improvements on machines and new processes should not be considered as safe lines for new firms who have no connection or experience in the older devices or older methods of production. The interest of those familiar with the trade should be always first sought.

The patent agent may be able to secure his patent, and may give excellent counsel as to where to go and what to do, but there are few who can put the inventor in actual communication with some person who will take up his invention without further cost to him, and who will then undertake to make and pay him for all they introduce.

Most inventors have too exaggerated an idea of the value attaching to their inventions, and they invariably assess the financial considerations in sums expressed by four figures, that is in thousands of pounds. When this condition exists, and while it lasts, all advice from experienced agents is declined, and the inventor goes his own dreary way towards disappointment and loss.

Unquestionably the two easiest ways to be recommended for the consideration of the patentee not actually in the industry are—first, granting a license to a manufacturer; and second, assigning his interest in the patent grant—that is, selling his patent outright. If he elects to follow the latter course, it may safely be assumed that one of two conditions will attach to the transaction; either he will obtain too small a sum, or he will be paid too much for his invention, for it is practically impossible to accurately assess the value of any invention before it has been commercially tested. The number of manufacturers who are willing to purchase a patent outright are very few compared to those willing or anxious to take up a license, which, while it may cost them little or nothing to acquire, will probably bring them a profitable monopoly during the life of the patent. Company-promoting patentees find fewer followers every year, owing to the enormous losses which have resulted from over-sanguine investments in this direction.

## CHAPTER XI.

## DESIGNS.

THERE are very many articles which, although scarcely capable of being considered good subject-matter for Letters Patent, are original in their configuration, and possess elements of novelty that go towards making them valuable and useful to the originators. The ingenuity that is exercised in producing a new form or shape of an article of commerce, in order that a special trade may thereby be obtained for it, is as much a benefit to industry, and thus open to recognition from the State, as the somewhat different order of ingenuity that devises a new combination of old parts for producing that which is termed "a new invention." It may well be that comparatively few of the alterations in form, outline, and configuration bring proportionate benefit to their originators, but this failure to obtain a return is due rather to the originators than to the national system which, for the encouragement of new industries, protects those who devise new designs, provided they register such new designs before placing them on the market.

Many new tools, implements, brackets, and other useful devices and commercial articles depend for their special utility absolutely upon the particular shape or form in which they are produced, as no other form or shape can be made capable of giving the same satisfaction or procuring the same amount of support from users or purchasers. Obviously, therefore, the protection of such outline or form by registration of the design at a trifling cost is quite as good a means of encouraging artistic or constructive skill by securing the rights of the owner for an initial period of five years, and, under the new Act, for two successive additional periods of five years, as would be the most carefully drawn patent specification for the same article, even if such were quite capable of being patented.

Changes of form of many well-known mechanical tools or appliances would mean less efficiency in the output. Changes of shape of many metal articles would produce less satisfactory results; while changes of ornamental outline might mean total loss of trade, seeing that the eye would be less pleased with the alteration. The design, therefore, or the shape, form, or configuration is vital to the commercial success of that which is produced in connection with many industrial products. In matters of an alleged infringement of any design, the simple test is that of the eye—that is, will the eye be deceived by taking one design for the other.

Manufacturers risk much, and even lose considerably, by neglecting to register their new designs; or, when registering them personally, by failing to efficiently protect themselves through an improper description they may have given of the essential features of that part for which they seek protection. Were the Design Law better known and more skilfully taken advantage of, manufacturers and others would secure themselves against the piracy by foreigners and others of their creations, and consequently against loss of trade by too keen or unfair competition.

Under the new Act greater liberty to register the design in different classes is given the designer and manufacturer with less risks concerning the manner in which an article that is the subject of a registered design is produced or commercially placed on the market. It has hitherto been the practice to prevent a design from being registered in one class if it had previously been published or registered in another class, notwithstanding the fact that it might never have been used or applied to the class of goods for which a particular manufacturer desired to apply it by the person who used the design in a totally different class of goods, and who had no conception that it could be usefully employed in another industry.

It has been sometimes a matter of difficulty for a manufacturer to maintain the validity of his design registration against an infringer, owing to the irregular

manner or careless method of marking the registered number of the registered article adopted by his employees. While the law under section 54 requires that all articles shall be marked with the registered number before they are delivered for sale, yet there is a safeguard for the life or existence of the design should there be a failure to so mark, provided such failure was unintentional. Sub-section *b*, of section 54, gives to a manufacturer an opportunity of recovering damages in respect of any infringement of his copyright in the design in a case where the infringer alleges as a defence that there has been a failure to mark the article, provided that the owner of the design can show that he took all proper steps to ensure the marking of the article, or, that the guilty person knew of the copyright in the design before the infringement was committed. Guilty knowledge is, in fact, made a cause for damages even although there has been a technical breach of the conditions requiring the marking of the article with the number of the registered design thereon.

It is frequently desirable for a designer to ascertain whether that which he has designed is likely to suit the purposes of an industry or a customer before taking proceedings to register it, but in the past there has been a great risk attaching to the disclosure of a design by the originator before he had obtained registration therefor. Section 55, under the new Act, comes to the aid of the designer or manufacturer who wishes to test the market by submitting a confidential sample, or to test the value of the design by offering it to some one who may be supposed to be interested therein before seeking to register it, as the section definitely provides that the disclosure of the design in confidence to another, or the acceptance of the first order, shall not be deemed to be a publication of the design sufficient to invalidate the subsequent registration thereof. Designs that are registered in this country in order to enable a foreigner to capture British trade by preventing the manufacture of the articles that he has copyrighted in this country for enabling him to import goods made after such or with such design thereon, will be capable of being set on one side by any person

who may apply to the Comptroller for the cancellation of the registration "on the ground that the design is used for manufacture exclusively or mainly outside the United Kingdom." The intention of the design registration, as with patents for invention, is for the encouragement of home manufacture, not for the prevention of it, by causing the articles to become the proprietary rights of any person who exercises the design in a foreign country by making it there while selling it in this country, where others are prevented from making or selling it even though they could do so in a cheaper and more efficient manner.

## PATENTS AND DESIGNS ACTS, 1907.

THE following is the full text of the new British Patents and Designs Consolidation and Amendment Act, passed on August 28, 1907, which repeals all previous Acts, and became operative on January 1, 1908. The new or amended parts introduced in the Patents and Designs (Amendment) Act, 1907, are shown in italics.

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### PART I.

#### PATENTS.

##### *Application for and grant of Patent.*

1.—(1) An application for a patent may be made by any person who claims to be the true and first inventor of an invention, whether he is a British subject or not, and whether alone or jointly with any other person.

(2) The application must be made in the prescribed form, and must be left at, or sent by post to, the Patent Office in the prescribed manner.

(3) The application must contain a declaration to the effect that the applicant is in possession of an invention, whereof he, or in the case of a joint application one at least of the applicants, claims to be the true and first inventor, and for which he desires to obtain a patent, and must be accompanied by either a provisional or complete specification.

(4) The declaration required by this section may be either a statutory declaration or not, as may be prescribed.

2.—(1) A provisional specification must describe the nature of the invention.

(2) *A complete specification must particularly describe and ascertain the nature of the invention and the manner in which the same is to be performed.*

(3) *In the case of any provisional or complete specification, where the comptroller deems it desirable he may require that suitable drawings shall be supplied with the specification, or at any time before the acceptance of same, and such drawings shall be deemed to form part of the said specification.*

(4) A specification, whether provisional or complete, must commence with the title, and in the case of a complete specification must end with a distinct statement of the invention claimed.

(5) *Where the invention in respect of which an application is made is a chemical invention, such typical samples and specimens as may be prescribed shall, if in any particular case the comptroller considers it desirable so to require, be furnished before the acceptance of the complete specification.*

3.—(1) The Comptroller-General of Patents, Designs, and Trade Marks (hereinafter referred to as the comptroller) shall refer every application to an examiner.

(2) If the examiner reports that the nature of the invention is not fairly described, or that the application, specification, or drawings have not been prepared in the prescribed manner, or that the title does not sufficiently indicate the subject-matter of the invention, the comptroller may refuse to accept the application or require that the application, specification, or drawing be amended before he proceeds with the application; and in the latter case the application shall, if the comptroller so directs, bear date as from the time when the application is complied with.

(3) Where the comptroller refuses to accept an application or requires an amendment, the applicant may appeal from his decision to the law officer, who shall, if required, hear the applicant and the comptroller, and may make an order determining whether and subject to what conditions (if any) the application shall be accepted.

(4) The comptroller shall, when an application has been accepted, give notice thereof to the applicant.

4. Where an application for a patent in respect of an invention has been accepted, the invention may during the period between the date of the application and the date of sealing such patent be used and published without prejudice to the patent to be granted for the invention; and such protection from the consequences of use and publication is in this Act referred to as provisional protection.

5.—(1) If the applicant does not leave a complete specification with his application, he may leave it at any subsequent time within six months from the date of the application.

*Provided that where an application is made for an extension of the time for leaving a complete specification the comptroller shall, on payment of the prescribed fee, grant an extension of time to the extent applied for but not exceeding one month.*

(2) Unless a complete specification is so left the application shall be deemed to be abandoned.

6.—(1) Where a complete specification is left after a provisional specification, the comptroller shall refer both specifications to an examiner.

(2) If the examiner reports that the complete specification has not been prepared in the prescribed manner, the comptroller may refuse to accept the complete specification until it has been amended to his satisfaction.

(3) If the examiner reports that the invention particularly described in the complete specification is not substantially the same as that which is described in the provisional specification the comptroller may—



- (a) refuse to accept the complete specification until it has been amended to his satisfaction ; or
- (b) *(with the consent of the applicant) cancel the provisional specification and treat the application as having been made on the date at which the complete specification was left, and the application shall have effect as if made on that date :*

*Provided that where the complete specification includes an invention not included in the provisional specification, the comptroller may allow the original application to proceed so far as the invention included both in the provisional and in the complete specification is concerned, and treat the claim for the additional invention included in the complete specification as an application for that invention made on the date at which the complete specification was left.*

(4) A refusal of the comptroller to accept a complete specification shall be subject to appeal to the law officer, who shall, if required, hear the applicant and the comptroller, and may make an order determining whether and subject to what conditions (if any) the complete specification shall be accepted.

(5) Unless a complete specification is accepted within twelve months from the date of the application, the application shall (except where an appeal has been lodged) become void.

*Provided that where an application is made for an extension of time for the acceptance of a complete specification, the comptroller shall, on payment of the prescribed fee, grant an extension of the time to the extent applied for but not exceeding three months.*

7.—(1) Where an application for a patent has been made and a complete specification has been left, the examiner shall, in addition to the other inquiries which he is directed to make by this Act, make a further investigation for the purpose of ascertaining whether the invention claimed has been wholly or in part claimed or described in any specification (other than a provisional specification not followed by a complete specification)

published before the date of the application, and left pursuant to any application for a patent made in the United Kingdom within fifty years next before the date of the application.

(2) If on investigation it appears that the invention has been wholly or in part claimed or described in any such specification, the applicant shall be informed thereof, and the applicant may, within such time as may be prescribed, amend his specification, and the amended specification shall be investigated in like manner as the original specification.

(3) If the comptroller is satisfied that no objection exists to the specification on the ground that the invention claimed thereby has been wholly or in part claimed or described in a previous specification as before mentioned, he shall, in the absence of any other lawful ground of objection, accept the specification.

(4) If the comptroller is not so satisfied, he shall, after hearing the applicant, and unless the objection is removed by amending the specification to the satisfaction of the comptroller, determine whether a reference to any, and, if so, what prior specification ought to be made in the specification by way of notice to the public.

*Provided that the comptroller, if satisfied that the invention claimed has been wholly and specifically claimed in any specification to which the investigation has extended, may, in lieu of requiring references to be made in the applicant's specification as aforesaid, refuse to grant a patent.*

(5) An appeal shall lie from the decision of the comptroller under this section to the law officer.

(6) The investigations and reports required by this section shall not be held in any way to guarantee the validity of any patent, and no liability shall be incurred by the Board of Trade or any officer thereof by reason of or in connection with any such investigation or report, or any proceeding consequent thereon.

8.—(1) *An investigation under the last preceding section shall extend to specifications published after the date of the application in respect of which the investigation is made, and being specifications which have been deposited pursuant to prior applications; and that section shall, subject to rules under this Act, have effect accordingly.*

(2) *Where, on such an extended investigation, it appears that the invention claimed in the specification deposited pursuant to an application is wholly or in part claimed in any published specification deposited pursuant to a prior application, the applicant shall, whether or not his specification has been accepted or a patent granted to him, be afforded such facilities as may be prescribed for amending his specification, and in the event of his failing to do so the comptroller shall, in accordance with such procedure as may be prescribed, determine what reference, if any, to other specifications ought to be made in his specification by way of notice to the public.*

(3) *For the purposes of this section an application shall be deemed to be prior to another application if the patent applied for when granted would be of prior date to the patent granted pursuant to that other application.*

(4) *This section shall come into operation at such date as the Board of Trade may by order direct, and shall apply only to applications made after that date, and the order shall be laid before both Houses of Parliament.*

9. *On the acceptance of the complete specification the comptroller shall advertise the acceptance; and the application and specifications with the drawings (if any) shall be open to public inspection.*

10. *After the acceptance of a complete specification and until the date of sealing a patent in respect thereof, or the expiration of the time for sealing, the applicant shall have the like privileges and rights as if a patent for the invention had been sealed on the date of the acceptance of the complete specification. Provided that*

an applicant shall not be entitled to institute any proceeding for infringement until a patent for the invention has been granted to him.

11.—(1) Any person may at any time within two months from the date of the advertisement of the acceptance of a complete specification give notice at the Patent Office of opposition to the grant of the patent on any of the following grounds:—

- (a) that the applicant obtained the invention from him, or from a person of whom he is the legal representative; or
- (b) *that the invention has been claimed in any complete specification for a British patent which is or will be of prior date to the patent the grant of which is opposed, other than a specification deposited pursuant to an application made fifty years before the date of the application for such last-mentioned patent; or on the ground*
- (c) *that the nature of the invention or the manner in which it is to be performed is not sufficiently or fairly described and ascertained in the complete specification; or*
- (d) that the complete specification describes or claims an invention other than that described in the provisional specification, and that such other invention forms the subject of an application made by the opponent in the interval between the leaving of the provisional specification and the leaving of the complete specification,

but on no other ground.

(2) Where such notice is given the comptroller shall give notice of the opposition to the applicant, and shall, on the expiration of those two months, after hearing the applicant and the opponent, if desirous of being heard, decide on the case.

(3) The decision of the comptroller shall be subject to appeal to the law officer, who shall, if required, hear the applicant and the opponent, if the opponent is, in his opinion, a person entitled to be heard in opposition to the grant of the patent, and shall decide the case; and the law officer may, if he thinks fit, obtain the assistance of an expert, who shall be paid such remuneration as the law officer, with the consent of the Treasury, may determine.

12.—(1) If there is no opposition, or in case of opposition, if the determination is in favour of the grant of a patent, the comptroller shall grant a patent to the applicant, or in the case of a joint application to the applicants jointly, and shall seal the patent with the seal of the Patent Office.

(2) A patent shall be sealed as soon as may be, and not after the expiration of fifteen months from the date of application, provided that—

- (a) Where the comptroller has allowed an extension of the time within which a complete specification may be left or accepted, a further extension of four months after the said fifteen months shall be allowed for the sealing of the patent:
- (b) Where the sealing is delayed by an appeal to the law officer, or by opposition to the grant of the patent, the patent may be sealed at such time as the law officer may direct:
- (c) Where the patent is granted to the legal representative of an applicant who has died before the expiration of the time which would otherwise be allowed for sealing the patent, the patent may be sealed at any time within twelve months after the date of his death:
- (d) *Where in consequence of the neglect or failure of the applicant to pay any fee a patent cannot be sealed within the period allowed by this section, that period may, on payment of the prescribed*

*fee and on compliance with the prescribed conditions, be extended to such an extent as may be prescribed, and this provision shall, in such cases as may be prescribed and subject to the prescribed conditions, apply where the period allowed for the sealing of the patent has expired before the commencement of this Act.*

13. Except as otherwise expressly provided by this Act, a patent shall be dated and sealed as of the date of the application: Provided that no proceedings shall be taken in respect of an infringement committed before the publication of the complete specification.

14.—(1) A patent sealed with the seal of the Patent Office shall have the same effect as if it were sealed with the Great Seal of the United Kingdom, and shall have effect throughout the United Kingdom, and the Isle of Man.

Provided that a patentee may assign his patent for any place in or part of the United Kingdom, or Isle of Man, as effectually as if the patent were originally granted to extend to that place or part only.

(2) Every patent may be in the prescribed form and shall be granted for one invention only, but the specification may contain more than one claim; and it shall not be competent for any person in an action or other proceeding to take any objection to a patent on the ground that it has been granted for more than one invention.

15.—(1) A patent granted to the true and first inventor shall not be invalidated by an application in fraud of him, or by provisional protection obtained thereon, or by any use or publication of the invention subsequent to that fraudulent application during the period of provisional protection.

(2) Where a patent has been revoked on the ground of fraud, the comptroller may, on the application of the true inventor made in accordance with the provisions

of this Act, grant to him a patent in lieu of and bearing the same date as the patent so revoked :

*Provided that no action shall, save as otherwise expressly provided by this Act, be brought for any infringement of the patent so granted committed before the actual date when such patent was granted.*

16.—(1) *Where the same applicant has put in two or more provisional specifications for inventions which are cognate modifications one of the other, and has obtained thereby concurrent provisional protection for the same, and the comptroller is of opinion that the whole of such inventions are such as to constitute a single invention and may properly be included in one patent, he may accept one complete specification in respect of the whole of such applications and grant a single patent thereon.*

(2) *Such patent shall bear the date of the earliest of such applications, but in considering the validity of the same, and for the purpose of the provisions of this Act with respect to oppositions to the grant of patents, the court or the comptroller, as the case may be, shall have regard to the respective dates of the provisional specifications relating to the several matters claimed therein.*

#### *Term of Patent.*

17.—(1) *The term limited in every patent for the duration thereof shall, save as otherwise expressly provided by this Act, be fourteen years from its date.*

(2) *A patent shall, notwithstanding anything therein or in this Act, cease if the patentee fails to pay the prescribed fees within the prescribed time ; provided that the comptroller, upon the application of the patentee, shall, on receipt of such additional fee, not exceeding ten pounds, as may be prescribed, enlarge the time to such an extent as may be applied for, but not exceeding three months.*

(3) *If any proceeding is taken in respect of an infringement of the patent committed after a failure to*

pay any fee within the prescribed time, and before any enlargement thereof, the court before which the proceeding is proposed to be taken may, if it thinks fit, refuse to award any damages in respect of such infringement.

18.—(1) *A patentee may, after advertising in manner provided by rules of the Supreme Court his intention to do so, present a petition to the court praying that his patent may be extended for a further term, but such petition must be presented at least six months before the time limited for the expiration of the patent.*

(2) *Any person may give notice to the court of objection to the extension.*

(3) *On the hearing of any petition under this section the patentee and any person who has given such notice of objection shall be made parties to the proceeding, and the comptroller shall be entitled to appear and be heard, and shall appear if so directed by the court.*

(4) *The court, in considering its decision, shall have regard to the nature and merits of the invention in relation to the public, to the profits made by the patentee as such, and to all the circumstances of the case.*

(5) *If it appears to the court that the patentee has been inadequately remunerated by his patent, the court may by order extend the term of the patent for a further term not exceeding seven, or, in exceptional cases, fourteen years, or may order the grant of a new patent for such term as may be specified in the order and containing any restriction, conditions, and provisions the court may think fit.*

19.—(1) *Where a patent for an invention has been applied for or granted, and the applicant or the patentee, as the case may be, applies for a further patent in respect of any improvement on or modification of the invention, he may, if he thinks fit, in his application for the further patent, request that the term limited in that patent for the duration thereof be the same as that of the original patent or so much of that term as is unexpired.*

(2) *Where an application containing such a request is*



made, a patent (hereinafter referred to as a patent of addition) may be granted for such term as aforesaid.

(3) A patent of addition shall remain in force so long as the patent for the original invention remains in force, but no longer, and in respect of a patent of addition no fees shall be payable for renewal.

(4) The grant of a patent of addition shall be conclusive evidence that the invention is a proper subject for a patent of addition, and the validity of the patent shall not be questioned on the ground that the invention ought to have been the subject of an independent patent.

#### *Restoration of Lapsed Patents.*

20.—(1) Where any patent has become void owing to the failure of the patentee to pay any prescribed fee within the prescribed time, the patentee may apply to the comptroller in the prescribed manner for an order for the restoration of the patent.

(2) Every such application shall contain a statement of the circumstances which have led to the omission of the payment of the said prescribed fee.

(3) If it appears from such statement that the omission was unintentional and did not arise from any misconduct on the part of the patentee, the comptroller shall advertise the application in the prescribed manner, and within such time as may be prescribed any person may give notice of opposition at the Patent Office.

(4) Where such notice is given the comptroller shall notify the applicant thereof.

(5) After the expiration of the prescribed period the comptroller shall hear the case and, subject to an appeal to the court, issue an order either restoring the patent or dismissing the application: Provided that in every order under this section restoring a patent such provisions as may be prescribed shall be inserted for the protection of

*persons who may have availed themselves of the subject-matter of the patent after the patent had been announced as void in the illustrated official journal.*

### *Amendment of Specification.*

21.—(1) An applicant or a patentee may at any time, by request in writing left at the Patent Office, seek leave to amend his specification, including drawings forming part thereof, by way of disclaimer, correction, or explanation, stating the nature of, and the reasons for, the proposed amendment.

(2) The request and the nature of the proposed amendment shall be advertised in the prescribed manner, and at any time within one month from its first advertisement any person may give notice at the Patent Office of opposition to the amendment.

(3) Where such a notice is given the comptroller shall give notice of the opposition to the person making the request, and shall hear and decide the case.

(4) Where no notice of opposition is given, or the person so giving notice of opposition does not appear, the comptroller shall determine whether and subject to what conditions, if any, the amendment ought to be allowed.

(5) The decision of the comptroller in either case shall be subject to an appeal to the law officer, who shall, if required, hear the person making the request to amend and, where notice of opposition has been given, the person giving that notice, if he is, in the opinion of the law officer, entitled to be heard in opposition to the request, and, where there is no opposition, the comptroller may make an order determining whether and subject to what conditions (if any) the amendment ought to be allowed.

(6) No amendment shall be allowed that would make the specification, as amended, claim an invention sub-

stantially larger than or substantially different from the invention claimed by the specification as it stood before amendment.

(7) Leave to amend shall be conclusive as to the right of the party to make the amendment allowed, except in case of fraud; and the amendment shall be advertised in the prescribed manner, and shall in all courts and for all purposes be deemed to form part of the specification.

(8) This section shall not apply when and so long as any such action for infringement or proceeding before the court for the revocation of a patent is pending.

*22. In any action for infringement of a patent or proceedings before the court for the revocation of a patent the court may by order allow the patentee to amend his specification by way of disclaimer in such manner and subject to such terms as to costs, advertisement, or otherwise as the court may think fit :*

*Provided that no amendment shall be so allowed that would make the specification, as amended, claim an invention substantially larger than, or substantially different from, the invention claimed by the specification as it stood before the amendment, and where an application for such an order is made to the court notice of the application shall be given to the comptroller, and the comptroller shall have the right to appear and be heard, and shall appear if so directed by the court.*

23. Where an amendment of a specification by way of disclaimer, correction, or explanation, has been allowed under this Act, no damages shall be given in any action in respect of the use of the invention before the disclaimer, correction, or explanation, unless the patentee establishes to the satisfaction of the court that his original claim was framed in good faith and with reasonable skill and knowledge.

#### *Compulsory Licences and Revocation.*

24.—(1) Any person interested may present a petition to the Board of Trade alleging that the reasonable re-

quirements of the public with respect to a patented invention have not been satisfied, and praying for the grant of a compulsory licence, or, in the alternative, for the revocation of the patent.

(2) The Board of Trade shall consider the petition, and if the parties do not come to an arrangement between themselves the Board of Trade, if satisfied that a *prima facie* case has been made out, shall refer the petition to the *court*, and, if the Board are not so satisfied, they may dismiss the petition.

(3) Where any such petition is referred by the Board of Trade to the *court*, and it is proved to the satisfaction of the *court* that the reasonable requirements of the public with reference to the patented invention have not been satisfied, the patentee may be ordered by the *court* to grant licences on such terms as the *court* may think just, or, if the *court* are of opinion that the reasonable requirements of the public will not be satisfied by the grant of licences, the patent may be revoked by order of the *court*.

Provided that an order of revocation shall not be made before the expiration of three years from the date of the patent, or if the patentee gives satisfactory reasons for his default.

(4) On the hearing of any petition under this section the patentee and any person claiming an interest in the patent as exclusive licensee or otherwise, shall be made parties to the proceeding, and the law officer or such other counsel as he may appoint shall be entitled to appear and be heard.

(5) *For the purposes of this section the reasonable requirements of the public shall not be deemed to have been satisfied—*

(a) *if by reason of the default of the patentee to manufacture to an adequate extent and supply on reasonable terms the patented article, or any parts thereof which are necessary for its efficient*

*working, or to carry on the patented process to an adequate extent, or to grant licences on reasonable terms, any existing trade or industry, or the establishment of any new trade or industry in the United Kingdom is unfairly prejudiced, or the demand for the patented article or the article produced by the patented process is not reasonably met; or*

- (b) *if any trade or industry in the United Kingdom is unfairly prejudiced by the conditions attached by the patentee before or after the passing of this Act to the purchase, hire, or use of the patented article, or to the using or working the patented process.*

(6) An order of the court directing the grant of any licence under this section shall, without prejudice to any other method of enforcement, operate as if it were embodied in a deed granting a licence and made between the parties to the proceeding.

25.—(1) Revocation of a patent may be obtained on petition to the court.

(2) Every ground on which—

- (a) a patent might, immediately before the first day of January, one thousand eight hundred and eighty four, have been repealed by scire facias; or
- (b) *a patent may be revoked under this Act either by the comptroller or as an alternative to the grant of a compulsory licence;*

shall be available by way of defence to an action of infringement and shall also be a ground of revocation under this section.

(3) A petition for revocation of a patent may be presented—

- (a) by the Attorney-General or any person authorised by him; or

(b) by any person alleging—

(i) that the patent was obtained in fraud of his rights, or of the rights of any person under or through whom he claims; or

(ii) that he, or any person under or through whom he claims, was the true inventor of any invention included in the claim of the patentee; or

(iii) that he, or any person under or through whom he claims an interest in any trade, business, or manufacture, had publicly manufactured, used, or sold, within this realm, before the date of the patent, anything claimed by the patentee as his invention.

26.—(1) *Any person who would have been entitled to oppose the grant of a patent, or is the successor in interest of a person who was so entitled, may, within two years from the date of the patent, in the prescribed manner apply to the comptroller for an order revoking the patent on any one or more of the grounds on which the grant of the patent might have been opposed.*

*Provided that when an action for infringement or proceedings for the revocation of the patent are pending in any court, an application under this section shall not be made except with the leave of the court.*

(2) *The comptroller shall give notice of the application to the patentee, and after hearing the parties if desirous of being heard, may make an order revoking the patent or requiring the specification relating thereto to be amended by disclaimer, correction, or explanation, or dismissing the application; but the comptroller shall not make an order revoking the patent unless the circumstances are such as would have justified him in refusing to grant the patent had the proceedings been proceedings in an opposition to the grant of a patent.*

(3) *A patentee may at any time by giving notice in the prescribed manner to the comptroller offer to surrender his patent, and the comptroller may, if after giving notice*

of the offer, and hearing all parties who desire to be heard he thinks fit, accept the offer, and thereupon make an order for the revocation of the patent.

(4) Any decision of the comptroller under this section shall be subject to appeal to the court.

27.—(1) At any time not less than four years after the date of a patent, and not less than one year after the passing of this Act, any person may apply to the comptroller for the revocation of the patent on the ground that the patented article or process is manufactured or carried on exclusively or mainly outside the United Kingdom.

(2) The comptroller shall consider the application, and if after enquiry he is satisfied that the allegations contained therein are correct, then, subject to the provisions of this section, and unless the patentee proves that the patented article or process is manufactured or carried on to an adequate extent in the United Kingdom, or gives satisfactory reasons why the article or process is not so manufactured or carried on, the comptroller may make an order revoking the patent either—

(a) forthwith ; or

(b) after such reasonable interval as may be specified in the order, unless in the meantime it is shown to his satisfaction that the patented article or process is manufactured or carried on within the United Kingdom to an adequate extent :

Provided that no such order shall be made which is at variance with any treaty, convention, arrangement, or engagement with any foreign country or British possession.

(3) If within the time limited in the order the patented article or process is not manufactured or carried on within the United Kingdom to an adequate extent, but the patentee gives satisfactory reasons why it is not so manufactured or carried on, the comptroller may extend the period mentioned in the previous order for such period not exceeding twelve months as may be specified in the subsequent order.

(4) Any decision of the comptroller under this section shall be subject to appeal to the court, and on any such

*appeal the Law Officer, or such other counsel as he may appoint, shall be entitled to appear and be heard.*

### *Register of Patents.*

28.—(1) There shall be kept at the Patent Office a book, called the register of patents, wherein shall be entered the names and addresses of grantees of patents, notifications of assignments and of transmissions of patents, of licences under patents, and of amendments, extensions, and revocations of patents, and such other matters affecting the validity or proprietorship of patents as may be prescribed.

(2) The register of patents existing at the commencement of this Act shall be incorporated with and form part of the register of patents under this Act.

(3) The register of patents shall be prima facie evidence of any matters by this Act directed or authorised to be inserted therein.

(4) Copies of deeds, licences, and any other documents affecting the proprietorship in any letters patent or in any licence thereunder, must be supplied to the comptroller in the prescribed manner for filing in the Patent Office.

### *Crown.*

29. A patent shall have to all intents the like effect as against His Majesty the King as it has against a subject :

Provided that any Government department may, by themselves, their agents, contractors or others, at any time after the application, use the invention for the services of the Crown on such terms as may, either before or after the use thereof, be agreed on, with the approval of the Treasury, between the department and the patentee, or, in default of agreement, as may be settled by the Treasury after hearing all parties interested.

30.—(1) The inventor of any improvement in instruments or munitions of war may (either for or without



valuable consideration) assign to the Secretary of State for War *or the Admiralty* on behalf of His Majesty all the benefit of the invention and of any patent obtained or to be obtained for the invention ; and the Secretary of State *or the Admiralty* may be a party to the assignment.

(2) The assignment shall effectually vest the benefit of the invention and patent in the Secretary of State *or the Admiralty* on behalf of His Majesty, and all covenants and agreements therein contained for keeping the invention secret and otherwise shall be valid and effectual (notwithstanding any want of valuable consideration), and may be enforced accordingly by the Secretary of State *or the Admiralty*.

(3) Where any such assignment has been made, the Secretary of State *or the Admiralty* may at any time before the publication of the complete specification certify to the comptroller that, in the interest of the public service, the particulars of the invention and of the manner in which it is to be performed, should be kept secret.

(4) If the Secretary of State *or the Admiralty* so certify the application and specifications, and with the drawings (if any), and any amendment of the complete specification, and any copies of such documents and drawings shall, instead of being left in the ordinary manner at the Patent Office, be delivered to the comptroller in a packet sealed by authority of the Secretary of State *or the Admiralty*.

(5) The packet shall, until the expiration of the term during which a patent for the invention may be in force, be kept sealed by the comptroller, and shall not be opened save under the authority of an order of the Secretary of State *or the Admiralty* or of the law officer.

(6) The sealed packet shall be delivered at any time during the continuance of the patent to any person authorised by the Secretary of State *or the Admiralty* to receive it, and shall if returned to the comptroller be again kept sealed by him.

(7) On the expiration of the term of the patent, the sealed packet shall be delivered to the Secretary of State *or the Admiralty*.

(8) Where the Secretary of State *or the Admiralty* certify as aforesaid, after an application for a patent has been left at the Patent Office, but before the publication of the complete specification, the application and specifications, with the drawings (if any), shall be forthwith placed in a packet sealed by authority of the comptroller, and the packet shall be subject to the foregoing provisions respecting a packet sealed by authority of the Secretary of State *or the Admiralty*.

(9) No proceeding by petition or otherwise shall lie for revocation of a patent granted for an invention in relation to which a certificate has been given by the Secretary of State *or the Admiralty* as aforesaid.

(10) No copy of any specification or other document or drawing, by this section required to be placed in a sealed packet, shall in any manner whatever be published or open to the inspection of the public, but save as in this section otherwise directed, the provisions of the Act shall apply in respect of any such invention and patent as aforesaid.

(11) The Secretary of State *or the Admiralty* may at any time waive the benefit of this section with respect to any particular invention, and the specifications, documents, and drawings shall be thenceforth kept and dealt with in the ordinary way.

(12) The communication of any invention for any improvement in instruments or munitions of war to the Secretary of State *or the Admiralty*, or to any person or persons authorised by the Secretary of State *or the Admiralty* to investigate the same or the merits thereof, shall not, nor shall anything done for the purpose of the investigation, be deemed use or publication of such invention so as to prejudice the grant or validity of any patent for the same.

(13) *Rules may be made under this Act, after consultation with the Secretary of State and the Admiralty, for the purpose of ensuring secrecy with respect to patents to which this section applies, and those rules may modify any of the provisions of this Act in their application to such patents as aforesaid so far as may appear necessary for the purpose aforesaid.*

### *Legal Proceedings.*

31.—(1) In an action or proceeding for infringement or revocation of a patent, the Court may, if it think fit, and shall on the request of either of the parties to the proceeding, call in the aid of an assessor specially qualified and try the case wholly or partially with his assistance; the action shall be tried without a jury unless the Court otherwise directs.

(2) The Court of Appeal may, if they think fit, in any proceeding before them respectively call in the aid of an assessor as aforesaid.

(3) The remuneration, if any, to be paid to an assessor under this section shall be determined by the court or the Court of Appeal, as the case may be, and be paid as part of the expenses of the execution of this Act.

32. *A defendant in an action for infringement of a patent, if entitled to present a petition to the court for the revocation of the patent, may, without presenting such a petition, apply in accordance with the rules of the Supreme Court by way of counterclaim in the action for the revocation of the patent.*

### *Innocent Infringers.*

33. *A patentee shall not be entitled to recover any damages in respect of any infringement of a patent granted after the commencement of this Act from any defendant who proves that at the date of the infringement he was not aware, nor had reasonable means of making*

*himself aware, of the existence of the patent, and the marking of an article with the word "patent," "patented," or any word or words expressing or implying that a patent has been obtained for the article, stamped, engraved, impressed on, or otherwise applied to the article, shall not be deemed to constitute notice of the existence of the patent unless the word or words are accompanied by the year and number of the patent:*

*Provided that nothing in this section shall affect any proceedings for an injunction.*

**34.** In an action for infringement of a patent, the court may, on the application of either party, make such order for an injunction inspection or account, and impose such terms and give such directions respecting the same and the proceedings thereon, as the court may see fit.

**35.** In an action for infringement of a patent, the court may certify that the validity of the patent came in question; and if the court so certifies, then in any subsequent action for infringement the plaintiff in that action on obtaining a final order or judgment in his favour shall, unless the court trying the action otherwise directs, have his full costs, charges, and expenses as between solicitor and client.

**36.** Where any person claiming to be the patentee of an invention, by circulars, advertisements, or otherwise, threatens any other person with any legal proceedings or liability in respect of any alleged infringement of the patent, any person aggrieved thereby may bring an action against him, and may obtain an injunction against the continuance of such threats, and may recover such damage (if any) as he has sustained thereby, if the alleged infringement to which the threats related was not in fact an infringement of any legal rights of the person making such threats:

Provided that this section shall not apply if the person making such threats with due diligence commences and prosecutes an action for infringement of his patent.

Joint Patentees.

37. Where, after the commencement of this Act, a patent is granted to two or more persons jointly, they shall, unless otherwise specified in the patent, be treated for the purpose of the devolution of the legal interest therein as joint tenants, but, subject to any contract to the contrary, each of such persons shall be entitled to use the invention to his own profit without accounting to the others, but shall not be entitled to grant a licence without their consent, and, if any such person dies, his beneficial interest in the patent shall devolve on his personal representatives as part of his personal estate.

Conditions in a Licence.

38.—(1) It shall not be lawful in any contract made after the passing of this Act in relation to the sale or lease of, or licence to use or work any article or process protected by a patent to insert a condition the effect of which will be—

(a) to prohibit or restrict the purchaser, lessee, or licensee from using any article or class of articles, whether patented or not, or any patented process, supplied or owned by any person other than the seller, lessor, or licensor or his nominees; or

(b) to require the purchaser, lessee, or licensee to acquire from the seller, lessor, or licensor or his nominees, any article or articles not protected by the patent:

and any such condition shall be null and void, as being in restraint of trade and contrary to public policy.

Provided that this sub-section shall not apply if—

- (i) *the seller, lessor, or licensor proves that at the time the contract was entered into the purchaser, lessee, or licensee had the option of purchasing the article or obtaining a lease or licence on reasonable terms, without such conditions as aforesaid; and*
- (ii) *the contract entitles the purchaser, lessee, or licensee to relieve himself of his liability to observe any such condition on giving the other party three months' notice in writing and on payment in compensation for such relief in the case of a purchase, of such sum, or in the case of a lease or licence of such rent or royalty for the residue of the term of the contract, as may be fixed by an arbitrator appointed by the Board of Trade.*

(2) *Any contract relating to the lease of or licence to use or work any patented article or patented process, whether made before or after the passing of this Act, may at any time after the patent or all the patents by which the article or process was protected at the time of the making of the contract has or have ceased to be in force, and notwithstanding anything in the same or in any other contract to the contrary, be determined by either party on giving three months' notice in writing to the other party; but where any such notice is given determining any contract made before the commencement of this Act, the party giving the notice shall be liable to pay such compensation as failing agreement may be awarded by an arbitrator appointed by the Board of Trade.*

(3) *Any contract made before the passing of this Act relating to the lease or licence to use or work any patented article or process and containing any condition which, had the contract been made after the passing of this Act, would by virtue of this section have been null and void may at any time before the contract is determinable under the last preceding subsection, and notwithstanding anything in the same or any other contract to*

the contrary, be determined by either party on giving three months' notice in writing to the other party, but where any such notice is given the party giving the notice shall be liable to pay such compensation as, failing agreement, may be awarded by an arbitrator appointed by the Board of Trade.

(4) The insertion by the patentee in a contract made after the passing of this Act of any condition which by virtue of this section is null and void shall be available as a defence to an action for infringement of the patent to which the contract relates brought while that contract is in force.

(5) Nothing in this section shall—

- (a) affect any condition in a contract whereby a person is prohibited from selling any goods other than those of a particular person; or
- (b) be construed as validating any contract which would, apart from this section, be invalid; or
- (c) affect any right of determining a contract or condition in a contract exercisable independently of this section; or
- (d) affect any condition in a contract for the lease of or licence to use a patented article, whereby the lessor or licensor reserves to himself or his nominees the right to supply such new parts of the patented article as may be required to put or keep it in repair.

39.—(1) The comptroller shall, in proceedings relating to an opposition to the grant of a patent or to an application for the amendment of a specification or the revocation of a patent, have, by order, power to award to any party such costs as he may consider reasonable, and to direct how and by what parties they are to be paid, and any such order may be made a rule of the court.

(2) If a party giving notice of opposition to the grant of a patent or to the amendment of a specification, or applying to the comptroller for the revocation of a patent,

or giving notice of appeal from any decision of the comptroller neither resides nor carries on business in the United Kingdom, or the Isle of Man, the comptroller, or in case of appeal to the law officer, the law officer may require such party to give security for costs of the proceedings or appeal, and in default of such security being given may treat the proceedings or appeal as abandoned.

40. The law officer may examine witnesses on oath and administer oaths for that purpose, and may make rules regulating references and appeals to the law officer and the practice and procedure before him under this Part of this Act; and in any proceeding before the law officer under this Part of this Act, the law officer may order costs to be paid by either party, and any such order may be made a rule of the court.

#### *Anticipation.*

41.—(1) An invention covered by any patent applied for on or after the first day of January, one thousand nine hundred and five shall not be deemed to have been anticipated by reason only of its publication in a specification left pursuant to an application made in the United Kingdom not less than fifty years before the date of the application for the patent, or of its publication in a provisional specification of any date not followed by a complete specification.

(2) A patent shall not be held to be invalid by reason only of the invention in respect of which the patent was granted, or any part thereof, having been published prior to the date of the patent, if the patentee proves to the satisfaction of the court that the publication was made without his knowledge and consent, and that the matter published was derived or obtained from him, and, if he learnt of the publication before the date of his application for the patent, that he applied for and obtained protection for his invention with all reasonable diligence after learning of the publication.



42. A patent shall not be held invalid on the ground that the complete specification claims a further or different invention to that contained in the provisional, if the invention therein claimed, so far as it is not contained in the provisional, was novel at the date when the complete specification was put in, and the applicant was the first and true inventor thereof.

43.—(1) If the person claiming to be inventor of an invention dies without making an application for a patent for the invention, application may be made by, and a patent for the invention granted to, his legal representative.

(2) Every such application must contain a declaration by the legal representative that he believes him to be the true and first inventor of the invention.

44. If a patent is lost or destroyed, or its non-production is accounted for to the satisfaction of the comptroller, the comptroller may at any time seal a duplicate thereof.

45.—(1) The exhibition of an invention at an industrial or international exhibition, certified as such by the Board of Trade, or the publication of any description of the invention during the period of the holding of the exhibition, or the use of the invention for the purpose of the exhibition in the place where the exhibition is held, or the use of the invention during the period of the holding of the exhibition by any person elsewhere, without the privity or consent of the inventor, shall not prejudice the right of the inventor to apply for and obtain a patent in respect of the invention or the validity of any patent granted on the application, provided that—

(a) the exhibitor, before exhibiting the invention, gives the comptroller the prescribed notice of his intention to do so; and

(b) the application for a patent is made before or within six months from the date of the opening of the exhibition.

(2) His Majesty may by Order in Council apply this section to any exhibition mentioned in the Order in like manner as if it were an industrial or international exhibition certified as such by the Board of Trade, and any such Order may provide that the exhibitor shall be relieved from the condition of giving notice to the comptroller of his intention to exhibit, and shall be so relieved either absolutely or upon such terms and conditions as may be stated in the Order.

**46.—**(1) The comptroller shall issue periodically an illustrated journal of patented inventions, as well as reports of patent cases decided by courts of law, and any other information that he may deem generally useful or important.

(2) Provision shall be made by the comptroller for keeping on sale copies of such journal, and also of all complete specifications of patents in force, with any accompanying drawings.

(3) The comptroller shall continue, in such form as he deems expedient, the indexes and abridgments of specifications hitherto published, and shall prepare and publish such other indexes, abridgments of specifications, catalogues, and other works relating to inventions, as he thinks fit.

**47.—**(1) The control and management of the Patent Museum and its contents shall remain vested in the Board of Education, subject to such directions as His Majesty in Council may think fit to give.

(2) The Board of Education may at any time require a patentee to furnish them with a model of his invention on payment to the patentee of the cost of the manufacture of the model, the amount to be settled, in case of dispute, by the Board of Trade.

**48.—**(1) A patent shall not prevent the use of an invention for the purposes of the navigation of a foreign vessel within the jurisdiction of any of His Majesty's Courts in the United Kingdom, or Isle of Man, or the use of an invention in a foreign vessel within that juris-

diction, provided it is not used therein for or in connection with the manufacture or preparation of anything intended to be sold in or exported from the United Kingdom or Isle of Man.

(2) This section shall not extend to vessels of any foreign state of which the laws do not confer corresponding rights with respect to the use of inventions in British vessels while in the ports of that state, or in the waters within the jurisdiction of its courts.

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## PART II.

### DESIGNS.

#### *Registration of Designs.*

49.—(1) The comptroller may, *on the application made in the prescribed form and manner* of any person claiming to be the proprietor of any new or original design not previously published in the United Kingdom, register the design under this Part of this Act.

(2) The same design may be registered in more than one class, and in case of doubt as to the class in which a design ought to be registered, the comptroller may decide the question.

(3) The comptroller may, if he thinks fit, refuse to register any design presented to him for registration, but any person aggrieved by any such refusal may appeal to the Board of Trade, and the Board shall, after hearing the applicant and the comptroller, if so required, make an order determining whether, and subject to what conditions, if any, registration is to be permitted.

(4) *An application which, owing to any default or neglect on the part of the applicant, has not been completed so as to enable registration to be effected within the prescribed time shall be deemed to be abandoned.*

(5) *A design when registered shall be registered as of the date of the application for registration.*

50. *Where a design has been registered in one or more classes of goods the application of the proprietor of the design to register it in some one or more other classes shall not be refused, nor shall the registration thereof be invalidated—*

- (a) *on the ground of the design not being a new and original design, by reason only that it was so previously registered; or*
- (b) *on the ground of the design having been previously published in the United Kingdom, by reason only that it has been applied to goods of any class in which it was so previously registered.*

51.—(1) The comptroller shall grant a certificate of registration to the proprietor of the design when registered.

(2) The comptroller may, in case of loss of the original certificate, or in any other case in which he deems it expedient, furnish one or more copies of the certificate.

52.—(1) There shall be kept at the Patent Office a book called the Register of Designs wherein shall be entered the names and addresses of proprietors of registered designs, notifications of assignments and transmissions of registered designs, and such other matters as may be prescribed.

(2) The register of designs existing at the commencement of this Act shall be incorporated with and form part of the register of designs under this Act.

(3) The register of designs shall be prima facie evidence of any matters by this Act directed or authorised to be entered therein.

### *Copyright in Registered Designs.*

53.—(1) When a design is registered, the registered proprietor of the design shall, subject to the provisions

of this Act, have copyright in the design during five years from the date of registration.

(2) *If within the prescribed time before the expiration of the said five years application for the extension of the period of copyright is made to the comptroller in the prescribed manner, the comptroller shall on payment of the prescribed fee extend the period of copyright for a second period of five years from the expiration of the original period of five years.*

(3) *If within the prescribed time before the expiration of such second period of five years application for the extension of the period of copyright is made to the comptroller in the prescribed manner, the comptroller may, subject to any rules under this Act, on payment of the prescribed fee, extend the period of copyright for a third period of five years from the expiration of the second period of five years.*

54.—(1) Before delivery on sale of any articles to which a registered design has been applied, the proprietor shall—

- (a) (if exact representations or specimens were not furnished on the application for registration), furnish to the comptroller the prescribed number of exact representations or specimens of the design; and if he fails to do so, the comptroller may erase his name from the register, and thereupon the copyright in the design shall cease; and
- (b) cause each such article to be marked with the prescribed mark, or with the prescribed words or figures, denoting that the design is registered; and if he fails to do so the proprietor shall not

*be entitled to recover any penalty or damage in respect of any infringement of his copyright in the design unless he shows that he took all proper steps to ensure the marking of the article, or unless he shows that the infringement took place after the person guilty thereof knew or had received notice of the existence of the copyright in the design.*

(2) *Where a representation is made to the Board of Trade by or on behalf of any trade or industry that in the interests of the trade or industry it is expedient to dispense with or modify as regards any class or description of articles any of the requirements of this section as to marking, the Board may, if they think fit, by rule under this Act dispense with or modify such requirements as regards any such class or description of articles to such extent and subject to such conditions as they think fit.*

55. *The disclosure of a design by the proprietor to any other person, in such circumstances as would make it contrary to good faith for that other person to use or publish the design, and the disclosure of a design in breach of good faith by any person other than the proprietor of the design, and the acceptance of a first and confidential order for goods bearing a new or original textile design intended for registration, shall not be deemed to be a publication of the design sufficient to invalidate the copyright thereof if registration thereof is obtained subsequently to the disclosure or acceptance.*

56.—(1) *During the existence of copyright in a design, or such shorter period not being less than two years from the registration of the design as may be prescribed, the design shall not be open to inspection except by the proprietor, or a person authorised in writing by him or a person authorised by the comptroller or by the court, and furnishing such information as may enable the comptroller to identify the design, and shall not be open to the inspection of any person except in the presence of the comptroller, or of an officer acting under him, and on payment of the prescribed fee; and the person making the inspection shall not be entitled to take any copy of the design, or of any part thereof:*

*Provided that where registration of a design is refused on the ground of identity with a design already registered, the applicant for registration shall be entitled to inspect the design so registered.*

(2) *After the expiration of the copyright in the design, or such shorter period as aforesaid, the design shall be*



open to inspection, and copies thereof may be taken by any person on payment of the prescribed fee.

*(3) Different periods may be prescribed under this section for different classes of goods.*

57. On the request of any person furnishing such information as may enable the comptroller to identify the design, and on payment of the prescribed fee, the comptroller shall inform such person whether the registration still exists in respect of the design, and if so, in respect of what classes of goods, and shall state the date of registration, and the name and address of the registered proprietor.

58.—(1) *At any time after the registration of a design any person may apply to the comptroller for the cancellation of the registration on the ground that the design is used for manufacture exclusively or mainly outside the United Kingdom, and where such an application is made the provisions of this Act with respect to the revocation of patents worked outside the United Kingdom (including those relating to costs) shall apply with the necessary modifications, except that there shall be no appeal from the decision of the comptroller.*

(2) Such ground as aforesaid shall be available by way of a defence to an action for infringement of the copyright in the design.

### *Industrial and International Exhibitions.*

59.—(1) The exhibition at an industrial or international exhibition certified as such by the Board of Trade, or the exhibition elsewhere during the period of the holding of the exhibition, without the privity or consent of the proprietor, of a design, or of any article to which a design is applied, or the publication, during the holding of any such exhibition, of a description of a design, shall not prevent the design from being registered, or invalidate the registration thereof: Provided that—

- (a) The exhibitor, before exhibiting the design or article, or publishing the description of the design, gives the comptroller the prescribed notice of his intention to do so; and
- (b) The application for registration is made before or within six months from the date of the opening of the exhibition.

(2) His Majesty may, by Order in Council, apply this section to any exhibition mentioned in the Order in like manner as if it were an industrial or international exhibition certified as such by the Board of Trade, and any such Order may provide that the exhibitor shall be relieved from the condition of giving notice to the comptroller of his intention to exhibit, and shall be so relieved either absolutely or upon such terms and conditions as may be stated in the Order.

### *Legal Proceedings.*

60.—(1) During the existence of copyright in any design it shall not be lawful for any person—

- (a) For the purposes of sale to apply or cause to be applied to any article in any class of goods in which the design is registered the design or any fraudulent or obvious imitation thereof, except with the licence or written consent of the registered proprietor, *or to do anything with a view to enable the design to be so applied; or*
- (b) Knowing that the design or any fraudulent or obvious imitation thereof has been applied to any article without the consent of the registered proprietor to publish or expose *or cause to be published or exposed* for sale that article.

(2) If any person acts in contravention of this section he shall be liable for every contravention to pay to the registered proprietor of the design a sum not exceeding fifty pounds, recoverable as a simple contract debt, or if the proprietor elects to bring an action for the recovery



*of damages for such contravention, and for an injunction against the repetition thereof, he shall be liable to pay such damages as may be awarded and to be restrained by injunction accordingly;*

Provided that the total sum recoverable as a simple contract debt in respect of any one design shall not exceed one hundred pounds.

*61. The provisions of this Act with regard to certificates of the validity of a patent, and to the remedy in case of groundless threats of legal proceedings by a patentee shall apply in the case of registered designs in like manner as they apply in the case of patents, with the substitution of references to the copyright in a design for references to a patent, and of references to the proprietor of a design for references to the patentee, and of references to the design for references to the invention.*

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### PART III.

#### GENERAL.

##### *Patent Office and Proceedings thereat.*

**62.**—(1) The Treasury may continue to provide for the purposes of this Act and the Trade Marks Act, 1905, an office with all requisite buildings and conveniences, which shall be called, and is in this Act referred to as, the Patent Office.

(2) The Patent Office shall be under the immediate control of the comptroller, who shall act under the superintendence and direction of the Board of Trade.

(3) Any act or thing directed to be done by or to the comptroller may be done by or to any officer authorised by the Board of Trade.

(4) *Rules under this Act may provide for the establishment of branch offices for designs at Manchester or elsewhere, and for any document or thing required by this Act to be sent to or done at the Patent Office being sent to or done at any branch office which may be established.*

63.—(1) There shall continue to be a comptroller-general of patents, designs, and trade marks, and the Board of Trade may, subject to the approval of the Treasury, appoint the comptroller, and so many examiners and other officers and clerks, with such designations and duties as the Board of Trade think fit, and may remove any of those officers and clerks.

(2) The salaries of those officers and clerks shall be appointed by the Board of Trade, with the concurrence of the Treasury, and those salaries and the other expenses of the execution of this Act and the Trade Marks Act, 1905, shall continue to be paid out of money provided by Parliament.

64. Impressions of the seal of the Patent Office shall be judicially noticed and admitted in evidence.

#### *Fees.*

65. There shall be paid in respect of the grant of patents and the registration of designs, and applications therefor, and in respect of other matters with relation to patents and designs under this Act, such fees as may be, with the sanction of the Treasury, prescribed by the Board of Trade, so however that the fees prescribed in respect of the instruments and matters mentioned in the First Schedule to this Act shall not exceed those specified in that Schedule.

#### *Provisions as to Registers and other Documents in Patent Office.*

66. There shall not be entered in any register kept under this Act, or be receivable by the comptroller, any notice of any trust expressed or implied or constructive.

67. Every register kept under this Act shall at all convenient times be open to the inspection of the public, subject to the provisions of this Act and to such regulations as may be prescribed; and certified copies, sealed with the seal of the Patent Office, of any entry in any such register, shall be given to any person requiring the same on payment of the prescribed fee.

68. Reports of examiners made under this Act shall not in any case be published or be open to public inspection, and shall not be liable to production or inspection in any legal proceeding, unless the court or officer having power to order discovery in such legal proceeding certifies that such production or inspection is desirable in the interests of justice, and ought to be allowed.

69.—(1) Where an application for a patent has been abandoned, or become void, the specifications and drawings (if any) accompanying or left in connection with such application, shall not, save as otherwise expressly provided by this Act, at any time be open to public inspection or be published by the comptroller.

(2) Where an application for a design has been abandoned or refused the application and any drawings, photographs, tracings, representations, or specimens left in connection with the application shall not at any time be open to public inspection or be published by the comptroller.

70. The comptroller may, on request in writing accompanied by the prescribed fee,—

- (a) *correct any clerical error in or in connection with an application for a patent or in any patent or any specification;*
- (b) *cancel the registration of a design either wholly or in respect of any particular goods in connection with which the design is registered;*
- (c) *correct any clerical error in the representation of a design or in the name or address of the proprietor of any patent or design, or in any other matter which is entered upon the register of patents or the register of designs.*

71.—(1) Where a person becomes entitled by assignment, transmission, or other operation of law to a patent, or to the copyright in a registered design, the comptroller shall, on request and on proof of title to his satisfaction, register him as the proprietor of a patent or design.

(2) *Where any person becomes entitled as mortgagee, licensee, or otherwise to any interest in a patent or design the comptroller shall, on request and on proof of title to his satisfaction, cause notice of the interest to be entered in the prescribed manner in the register of patents or designs, as the case may be.*

(3) The person registered as the proprietor of a patent or design shall, subject to the provisions of this Act and to any rights appearing from the register to be vested in any other person, have power absolutely to assign, grant licences as to, or otherwise deal with, the patent or design and to give effectual receipts for any consideration for any such assignment, licence, or dealing: Provided that any equities in respect of the patent or design may be enforced in like manner as in respect of any other personal property.

72.—(1) *The court may, on the application in the prescribed manner of any person aggrieved by the non-insertion in or omission from the register of patents or designs of any entry, or by any entry made in either such register without sufficient cause, or by any entry wrongly remaining on either such register, or by an error or defect in any entry in either such register, make such order for making, expunging, or varying such entry as it may think fit.*

(2) *The court may in any proceeding under this section decide any question that it may be necessary or expedient to decide in connection with the rectification of a register.*

(3) *The prescribed notice of any application under this section shall be given to the comptroller, who shall have the right to appear and be heard thereon, and shall appear if so directed by the court.*

(4) *Any order of the court rectifying a register shall direct that notice of the rectification be served on the comptroller in the prescribed manner, who shall upon the receipt of such notice rectify the register accordingly.*

### *Powers and Duties of Comptroller.*

73. Where any discretionary power is by or under this Act given to the comptroller, he shall not exercise that power adversely to the applicant for a patent, or for amendment of a specification, or for registration of a design, without (if so required within the prescribed time by the applicant) giving the applicant an opportunity of being heard.

74. The comptroller may, in any case of doubt or difficulty arising in the administration of any of the provisions of this Act, apply to a law officer for directions in the matter.

75. The comptroller may refuse to grant a patent for an invention, or to register a design, of which the use would, in his opinion, be contrary to law or morality.

76. The comptroller shall, before the first day of June in every year, cause a report respecting the execution by or under him of this Act to be laid before both Houses of Parliament, and therein shall include for the year to which the report relates all general rules made in that year under or for the purposes of this Act, and an account of all fees, salaries, and allowances, and other money received and paid under this Act.

### *Evidence.*

77.—(1) *Subject to rules under this Act in any proceeding under this Act before the comptroller the evidence shall be given by statutory declaration in the absence of directions to the contrary; but in any case in which the comptroller thinks it right so to do, he may take evidence*

*vivâ voce in lieu of or in addition to evidence by declaration or allow any declarant to be cross-examined on his declaration. Any such statutory declaration may in the case of appeal be used before the court in lieu of evidence by affidavit, but if so used shall have all the incidents and consequences of evidence by affidavit.*

(2) *In case any part of the evidence is taken vivâ voce, the comptroller shall, in respect of requiring the attendance of witnesses and taking evidence on oath, be in the same position in all respects as an official referee of the Supreme Court.*

78. A certificate purporting to be under the hand of the comptroller as to any entry, matter, or thing which he is authorised by this Act, or any general rules made thereunder, to make or do, shall be *prima facie* evidence of the entry having been made, and of the contents thereof, and of the matter or thing having been done or left undone.

79. Printed or written copies of extracts, purporting to be certified by the comptroller and sealed with the seal of the Patent Office, of or from patents, specifications, and other documents in the Patent Office, and of or from registers and other books kept there, shall be admitted in evidence in all courts in His Majesty's dominion, and in all proceedings, without further proof or production of the originals.

80.—(1) Copies of all specifications, drawings, and amendments left at the Patent Office after the commencement of this Act, printed for and sealed with the seal of the Patent Office, shall be transmitted to the Edinburgh Museum of Science and Art, and to the Enrolments Office of the Chancery Division in Ireland, and to the Rolls Office in the Isle of Man, within twenty-one days after they have been accepted or allowed at the Patent Office.

(2) Certified copies of or extracts from any such documents shall be given to any person on payment of the prescribed fee; and any such copy or extract shall

be admitted in evidence in all courts in Scotland and Ireland and in the Isle of Man without further proof or production of the originals.

81. Any application, notice, or amendment authorised or required to be left, made, or given at the Patent Office or to the comptroller, or to any other person under this Act, may be sent by post.

82. *Where the last day fixed by this Act for doing anything under this Act falls on any day specified in rules under this Act as an excluded day, the rules may provide for the thing being done on the next following day not being an excluded day.*

83.—(1) If any person is, by reason of infancy, lunacy, or other disability, incapable of making any declaration or doing anything required or permitted by or under this Act, the guardian or committee (if any) of the person subject to the disability, or, if there be none, any person appointed by any court possessing jurisdiction in respect of his property, may make such declaration or a declaration as nearly corresponding thereto as circumstances permit, and do such thing in the name and on behalf of the person subject to the disability.

(2) An appointment may be made by the court for the purposes of this section upon the petition of any person acting on behalf of the person subject to the disability or of any other person interested in the making of the declaration or the doing of the thing.

### *Register of Patent Agents.*

84.—(1) A person shall not be entitled to describe himself as a patent agent, whether by advertisement, by description on his place of business, by any document issued by him, or otherwise, unless he is registered as a patent agent in pursuance of this Act or an Act repealed by this Act.

(2) Every person who proves to the satisfaction of the Board of Trade that prior to the twenty-fourth day of

December, one thousand eight hundred and eighty-eight, he had been bona fide practising as a patent agent shall be entitled to be registered as a patent agent in pursuance of this Act.

(3) If any person knowingly describes himself as a patent agent in contravention of this section, he shall be liable on conviction under the Summary Jurisdiction Acts to a fine not exceeding twenty pounds.

(4) In this section "patent agent" means exclusively an agent for obtaining patents in the United Kingdom.

**85.**—(1) *Rules under this Act may authorise the comptroller to refuse to recognise as agent in respect of any business under this Act any person whose name has been erased from the register of patent agents, or who is proved to the satisfaction of the Board of Trade, after being given an opportunity of being heard, to have been convicted of such an offence or to have been guilty of such misconduct as would have rendered him liable, if his name had been on the register of patent agents, to have his name erased therefrom, and may authorise the comptroller to refuse to recognise as agent in respect of any business under this Act any company which, if it had been an individual, the comptroller could refuse to recognise as such agent.*

(2) *Where a company or firm acts as agents, such rules as aforesaid may authorise the comptroller to refuse to recognise the company or firm as agent if any person whom the comptroller could refuse to recognise as an agent acts as director or manager of the company or is a partner in the firm.*

(3) *The comptroller shall refuse to recognise as agent in respect of any business under this Act any person who neither resides nor has a place of business in the United Kingdom or the Isle of Man.*

#### *Powers, &c., of Board of Trade.*

**86.**—(1) The Board of Trade may make such general rules and do such things as they think expedient, subject to the provisions of this Act—



- (a) For regulating the practice of registration under this Act :
- (b) For classifying goods for the purposes of designs :
- (c) For making or requiring duplicates of specifications, drawings, and other documents :
- (d) For securing and regulating the publishing and selling of copies, at such prices and in such manner as the Board of Trade think fit, of specifications, drawings, and other documents :
- (e) For securing and regulating the making, printing, publishing, and selling of indexes to, and abridgments of, specifications and other documents in the Patent Office ; and providing for the inspection of indexes and abridgments and other documents.
- (f) For regulating (with the approval of the Treasury) the presentation of copies of Patent Office publications to patentees and to public authorities, bodies, and institutions at home and abroad :
- (g) For regulating the keeping of the register of patent agents under this Act :
- (h) Generally for regulating the business of the Patent Office, and all things by this Act placed under the direction or control of the comptroller, or of the Board of Trade.

(2) General rules shall whilst in force be of the same effect as if they were contained in this Act.

(3) Any rules made in pursuance of this section shall be advertised twice in the official journal to be issued by the comptroller, and shall be laid before both Houses of Parliament as soon as practicable after they are made, and if either House of Parliament, within the next forty days after any rules have been so laid before that House, resolves that the rules or any of them ought to be

annulled, the rules or those to which the resolution applies shall after the date of such resolution be of no effect, without prejudice to the validity of anything done in the meantime under the rules or to the making of any new rules.

87.—(1) All things required or authorised under this Act to be done by, to, or before the Board of Trade, may be done by, to, or before the President or a secretary or an assistant secretary of the Board.

(2) All documents purporting to be orders made by the Board of Trade and to be sealed with the seal of the Board, are to be signed by a secretary or assistant secretary of the Board, or by any person authorised in that behalf by the President of the Board, shall be received in evidence, and shall be deemed to be such orders without further proof, unless the contrary is shown.

(3) A certificate, signed by the President of the Board of Trade, that any order made or act done is the order or act of the Board, shall be conclusive evidence of the fact so certified.

88. An order in Council under this Act shall, from a date to be mentioned for the purpose in the Order, take effect as if it had been contained in this Act; but may be revoked or varied by a subsequent order.

### *Offences.*

89. (1) If any person makes or causes to be made a false entry in any register kept under this Act, or a writing falsely purporting to be a copy of an entry in any such register, or produces or tenders or causes to be produced or tendered in evidence any such writing, knowing the entry or writing to be false, he shall be guilty of a misdemeanour.

(2) If any person falsely represents that any article sold by him is a patented article, or falsely describes

any design applied to any article sold by him as registered he shall be liable for every offence, on conviction under the Summary Jurisdiction Acts, to a fine not exceeding five pounds.

(3) If any person sells an article having stamped, engraved, or impressed thereon or otherwise applied thereto the word "patent," "patented," "registered," or any other word expressing or implying that the article is patented or that the design applied thereto is registered, he shall be deemed for the purposes of this section to represent that the article is a patented article or that the design applied thereto is a registered design.

(4) *Any person who, after the copyright in a design has expired, puts or causes to be put on any article to which the design has been applied the word "registered," or any word or words implying that there is a subsisting copyright in the design, shall be liable on summary conviction to a fine not exceeding five pounds.*

(5) *If any person uses on his place of business, or on any document issued by him, or otherwise, the words "Patent Office," or any other words suggesting that his place of business is officially connected with, or is, the Patent Office, he shall be liable on summary conviction to a fine not exceeding twenty pounds.*

90.—(1) *The grant of a patent under this Act shall not be deemed to authorise the patentee to use the Royal Arms or to place the Royal Arms on any patented Article.*

(2) *If any person, without the authority of His Majesty, uses in connection with any business, trade, calling, or profession the Royal Arms (or arms so nearly resembling them as to be calculated to deceive) in such manner as to be calculated to lead to the belief that he is duly authorised to use the Royal Arms, he shall be liable on summary conviction to a fine not exceeding twenty pounds.*

*Provided that nothing in this section shall be construed as affecting the right, if any, of the proprietor of a trade mark containing such arms to continue to use such trade mark.*

*International and Colonial Arrangements.*

91.—(1) If His Majesty is pleased to make any arrangement with the government of any foreign state for mutual protection of inventions, or designs, or trade marks, then any person who has applied for protection for any invention, design, or trade mark in that state shall be entitled to a patent for his invention or to registration of his design or trade mark under this Act or the Trade Marks Act, 1905, in priority to other applicants; and the patent or registration shall have the same date as the date of the application in the foreign state.

Provided that—

- (a) The application is made, in the case of a patent within twelve months, and in the case of a design or trade mark within four months, from the application for protection in the foreign state; and
- (b) Nothing in this section shall entitle the patentee or proprietor of the design or trade mark to recover damages for infringements happening prior to the actual date on which his complete specification is accepted, or his design or trade mark is registered in this country.

(2) The patent granted for the invention or the registration of a design or trade mark shall not be invalidated—

- (a) in the case of a patent, by reason only of the publication of a description of, or use of, the invention; or

(b) in the case of a design, by reason only of the exhibition or use of, or the publication of a description or representation of, the design ; or

(c) in the case of a trade mark, by reason only of the use of the trade mark, in the United Kingdom or the Isle of Man during the period specified in this section as that within which the application may be made.

(3) The application for the grant of a patent, or the registration of a design, or the registration of a trade mark under this section, must be made in the same manner as an ordinary application under this Act or the Trade Marks Act, 1905: Provided that—

(a) In the case of patents the application shall be accompanied by a complete specification, which, if it is not accepted within the twelve months, shall with the drawings (if any) be open to public inspection at the expiration of that period; and

(b) In the case of trade marks, any trade mark the registration of which has been duly applied for in the country of origin may be registered under the Trade Marks Act, 1905.

(4) The provisions of this section shall apply only in the case of those foreign states with respect to which His Majesty by Order in Council declares them to be applicable, and so long only in the case of each state as the Order in Council continues in force with respect to that state.

(5) Where it is made to appear to His Majesty that the legislature of any British possession has made satisfactory provision for the protection of inventions, designs, and trade marks, patented or registered in this country, it shall be lawful for His Majesty, by Order in Council, to apply the provisions of this section to that possession, with such variations or additions, if any, as may be stated in the Order.

*Definitions.*

**92.**—(1) In this Act “the court” means, subject to the provisions as Scotland, Ireland, and the Isle of Man, the High Court in England.

(2) *Where by virtue of this Act a decision of the comptroller is subject to an appeal to the court, or a petition may be referred or presented to the court, the appeal shall, subject to and in accordance with rules of the Supreme Court, be made and the petition referred or presented to such judge of the High Court as the Lord Chancellor may select for the purpose, and the decision of that judge shall be final, except in the case of an appeal from a decision of the comptroller revoking a patent on any ground on which the grant of such patent might have been opposed.*

**NOTE.**—By an Act passed in 1908, “The Patents and Designs Act 1908,” to explain section 92, it was therein declared: “That so much of sub-section (2) as provides that the decision of a judge of the High Court to whom a petition is presented by virtue of that Act is to be final, does not apply in the case of a petition for the revocation of a patent under section twenty-five of that Act.”

**93.** In this Act, unless the context otherwise requires,—

“Law officer” means the Attorney-General or Solicitor-General for England:

“Prescribed” means prescribed by general rules under this Act:

“British possession” does not include the Isle of Man or the Channel Islands:

“Patent” means letters patent for an invention:

“Patentee” means the person for the time being entitled to the benefit of a patent:

"Invention" means any manner of new manufacture the subject of letters patent and grant of privilege within section twenty-six of the Statute of Monopolies (that is, the Act of the twenty-first year of the reign of King James the First, chapter three, intituled "An Act concerning monopolies and dispensations with "penal laws and the forfeiture thereof"), and includes an alleged invention:

"Inventor" and "applicant" shall, subject to the provisions of this Act, include the legal representative of a deceased inventor or applicant:

"Design" means any design (not being a design for a sculpture or other thing within the protection of the Sculpture Copyright Act, 1814) applicable to any article, whether the design is applicable for the pattern, or for the shape or configuration, or for the ornament thereof, or for any two or more of such purposes, and by whatever means it is applicable, whether by printing, painting, embroidering, weaving, sewing, modelling, casting, embossing, engraving, staining, or any other means whatever, manual, mechanical, or chemical, separate or combined:

"Article" means (as respects designs) any article of manufacture and any substance artificial or natural, or partly artificial and partly natural:

"Copyright" means the exclusive right to apply a design to any article in any class in which the design is registered:

"Proprietor of a new and original design,"—

(a) Where the author of the design, for good consideration, executes the work for some other person, means the person for whom the design is so executed; and

(b) Where any person acquires the design or the right to apply the design to any article, either exclusively of any other person or otherwise, means, in the respect and to the extent in and to which the design or right has been so acquired, the person by whom the design or right is so acquired; and

(c) In any other case, means the author of the design;

and where the property in, or the right to apply, the design has devolved from the original proprietor upon any other person, includes that other person.

*Application to Scotland, Ireland, and the Isle of Man.*

**94.** In the application of this Act to Scotland—

- (1) In any action for infringement of a patent in Scotland the provisions of this Act with respect to calling in the aid of an assessor shall apply, and the action shall be tried without a jury, unless the court otherwise direct, but otherwise nothing shall affect the jurisdiction and forms of process of the courts in Scotland in such an action or in any action or proceeding respecting a patent hitherto competent to those courts; and for the purposes of the provisions so applied "court of appeal" shall mean any court to which such action is appealed:
- (2) Any offence under this Act declared to be punishable on conviction under the Summary Jurisdiction Acts may be prosecuted in the sheriff court:
- (3) Proceedings for revocation of a patent shall be in the form of an action of reduction at the



instance of the Lord Advocate, or at the instance of a party having interest with his concurrence, which concurrence may be given on just cause shown only, and services of all writs and summonses in that action shall be made according to the forms and practice existing at the commencement of this Act;

- (4) The provisions of this Act conferring a special jurisdiction on the court as defined by this Act, shall not, except so far as the jurisdiction extends, affect the jurisdiction of any court in Scotland in any proceedings relating to patents or to designs; and with reference to any such proceedings, the term "the court" shall mean any Lord Ordinary of the Court of Session, and the term "Court of Appeal" shall mean either Division of that Court:
- (5) Notwithstanding anything in this Act, the expression "the Court" shall, as respects petitions for compulsory licences on revocation which are referred by the Board of Trade to the Court in Scotland, mean any Lord Ordinary of the Court of Session, and shall in reference to proceedings in Scotland for the extension of the time of a patent mean such Lord Ordinary.
- (6) The expression "Rules of the Supreme Court" shall, except in section 92 of this Act, mean act of sederunt.
- (7) If any rectification of a register under this Act is required in pursuance of any proceeding in a court, a copy of the order, decree or other authority for the rectification, shall be served on the comptroller, and he shall rectify the register accordingly:
- (8) The expression "injunction" means "interdict."

- (1) All parties shall, notwithstanding anything in this Act, have in Ireland their remedies under or in respect of a patent as if the same had been granted to extend to Ireland only :
- (2) The provisions of this Act conferring a special jurisdiction on the court, as defined by this Act, shall not, except so far as the jurisdiction extends, affect the jurisdiction of any court in Ireland in any proceedings relating to patents or to designs ; and with reference to any such proceedings to the term " the Court " means the High Court in Ireland :
- (3) If any rectification of a register under this Act is required in pursuance of any proceeding in a court, a copy of the order, decree, or other authority for the rectification shall be served on the comptroller and he shall rectify the register accordingly.

96. This Act shall extend to the Isle of Man, subject to the following modifications :—

- (1) Nothing in this Act shall affect the jurisdiction of the courts in the Isle of Man in proceedings for infringement, or in any action or proceedings respecting a patent or design competent to those courts :
- (2) The punishment for a misdemeanour under this Act in the Isle of Man shall be imprisonment for any term not exceeding two years, with or without hard labour, and with or without a fine not exceeding one hundred pounds, at the discretion of the court :
- (3) Any offence under this Act committed in the Isle of Man which would in England be punishable on summary conviction may be prosecuted, and any fine in respect thereof recovered, at the instance of any person aggrieved in the manner in which offence punishable on summary conviction may for the time being be prosecuted.

*Repeals, Savings, and Short Title.*

97. Nothing in this Act shall take away, abridge, or prejudicially affect the prerogative of the Crown in relation to the granting of any letters patent or to the withholding of a grant thereof.

98.—(1) The enactments mentioned in the Second Schedule to this Act are hereby repealed to the extent specified in the third column of that schedule—

- (a) As respects the enactments mentioned in Part I. of that Schedule, as from the commencement of this Act;
- (b) *As respects the enactments mentioned in Part III. of that Schedule, as from the date when rules of the Supreme Court regulating the matters dealt with in those enactments come into operation.*
- (c) *As respects the enactments mentioned in Part III. of that Schedule, as from the date when rules under this Act regulating the matters dealt with in those enactments come into operation;*

*and the enactments mentioned in Part II. and Part III. of that Schedule shall, until so repealed, have effect as if they formed part of this Act:*

Provided that this repeal shall not affect any convention, Order in Council, rule, or table of fees having effect under any enactment so repealed, but any such convention, Order in Council, rule, or table of fees in force at the commencement of this Act shall continue in force, and may be repealed, altered or amended, as if it had been made under this Act.

(2) *Except where otherwise expressly provided, this Act shall extend to all patents granted and all designs registered before the commencement of this Act, and to*

applications then pending, in substitution for such enactments as would have applied thereto if this Act had not been passed.

99. This Act may be cited as the Patents and Designs Act, 1907, and shall come into operation on the *first day of January, one thousand nine hundred and eight.*

# SCHEDULES.

## FIRST SCHEDULE.

### FEES ON INSTRUMENTS FOR OBTAINING PATENTS AND RENEWAL

#### (a) Up to Sealing.

	£	s.	d.	£	s.	d.
On application for provisional protection .....	1	0	0			
On filing complete specification .....	3	0	0			
				4	0	0

or

On filing complete specification with first application ...	4	0	0
On the sealing of the patent in respect of investigations as to anticipation .....	1	0	0

#### (b) Further before end of four years from date of patent.

On certificate of renewal .....	50	0	0
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#### (c) Further before end of eight years from date of patent.

On certificate of renewal .....	100	0	0
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Or in lieu of the fees of £50 and £100 the following  
annual fees :—

Before the expiration of the fourth year from the date of the patent	10	0	0
„ „ fifth „ „	10	0	0
„ „ sixth „ „	10	0	0
„ „ seventh „ „	10	0	0
„ „ eighth „ „	15	0	0
„ „ ninth „ „	15	0	0
„ „ tenth „ „	20	0	0
„ „ eleventh „ „	20	0	0
„ „ twelfth „ „	20	0	0
„ „ thirteenth „ „	20	0	0

## SECOND SCHEDULE.

## ENACTMENTS REPEALED.

## PART I.

Session and Chapter.	Short Title.	Extent of Repeal.
46 & 47 Vict. c. 57.	The Patents, Designs, and Trade Marks Act, 1883.	The whole Act, except sub-sections (5), (6), and (7) of section twenty-six, section twenty-nine, sub-sections (2) and (3) of section forty-seven, and section forty-eight.
48 & 49 Vict. c. 63.	The Patents, Designs, and Trade Marks (Amendment) Act, 1885.	The whole Act.
49 & 50 Vict. c. 37.	The Patents Act, 1886.	The whole Act.
51 & 52 Vict. c. 50.	The Patents, Designs, and Trade Marks Act, 1888.	The whole Act.
1 Edw. 7, c. 18.	The Patents Act, 1901.	The whole Act.
2 Edw. 7, c. 34.	The Patents Act, 1902.	The whole Act.
7 Edw. 7, c. 28.	The Patents and Designs (Amendment) Act, 1907.	The whole Act.

## PART II.

Session and Chapter.	Short Title.	Extent of Repeal.
46 & 47 Vict. c. 57.	The Patents, Designs, and Trade Marks Act, 1883.	Sub-sections (5), (6), and (7) of section twenty-six, and section twenty-nine.

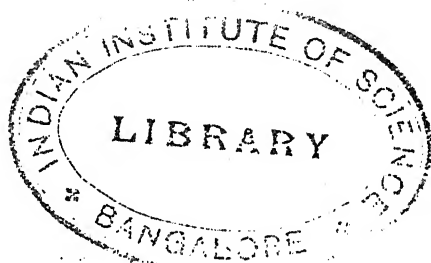
## PART III.

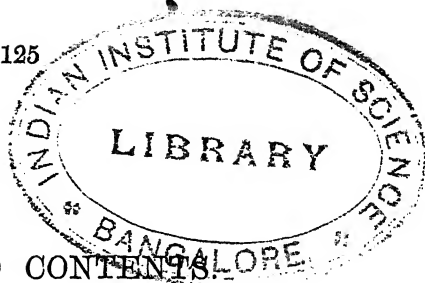
Session and Chapter.	Short Title.	Extent of Repeal.
46 & 47 Vict. c. 57.	The Patents, Designs, and Trade Marks Act, 1883.	Sub-sections (2) and (3) of section forty-seven, and section forty-eight.

## NOTE BY AUTHOR AS TO RENEWAL FEES.

The renewal fees mentioned in the Act, are the maximum that the Patent Office can charge, but these fees are by rule now much lower, as follows: At the end of the fourth year £5, the fifth year £6, and then an increasing amount of £1 annually, amounting for the last, or fourteenth year, to £14.

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